

No. 11652.

IN THE

United States Circuit Court of Appeals

FOR THE NINTH CIRCUIT

LeROY J. LEISHMAN,

Defendant-Appellant and Cross-Appellee,

vs.

RADIO CONDENSER COMPANY and GENERAL INSTRUMENT
CORPORATION,

Plaintiffs-Appellees and Cross-Appellants.

BRIEF FOR PLAINTIFFS-APPELLEES AND OPENING BRIEF FOR APPELLEES AND CROSS-APPELLANTS.

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RADIO CONDENSER COMPANY and GENERAL INSTRUMENT
CORPORATION,

Plaintiffs-Appellees and Cross-Appellants.

PLAINTIFFS-APPELLEES AND CROSS- APPELLANTS' OPENING BRIEF.

This cause comes before this Court on an appeal and a cross-appeal from a declaratory judgment [I-94]* in an action under §274-d (28 U. S. C. §400) of the Judicial Code.

Plaintiffs** Radio Condenser Company and General Instrument Corporation are corporations of the State of New Jersey and brought this action against defendant

*The printed transcript of record is herein referred to by Roman numerals designating the volume, followed by the reference page number.

**Herein the parties will be referred to as "plaintiffs" and "defendant" as in the court below.

LeRoy J. Leishman, a resident of the City of Los Angeles and of the Southern District of California.

The “actual controversy” upon which the action is based is and was with respect to the validity of the defendant’s Reissue Letters Patent 20,827 and the asserted infringement of claims 7 to 11, inclusive, thereof by the manufacture and sale of radio condensers and tuners by the plaintiffs.

The appealed judgment is a summary judgment that plaintiffs’ condensers and tuners do not infringe either of said claims of said reissue patent and granting additional relief, *i. e.*, an injunction prohibiting defendant “from asserting, contending, claiming, or alleging that said Reissue Letters Patent * * * has been or is being infringed” by either of the plaintiffs [I-95, par. 2] or “that the use or sale of condensers and tuners manufactured by plaintiffs * * * has been or is an infringement * * *” of said reissue patent [*id.* par. 3] and “from prosecuting any action in law or equity in which condensers and tuners manufactured by plaintiffs, or either of them, * * * are asserted to have been or to be an infringement” of said reissue patent [I-96 par. 4]. Defendant’s appeal is from that portion of said judgment [I-94-95 par. 1], “That the plaintiffs have not infringed” said patent.

Upon motion of defendant the injunction of paragraph 3 of the judgment [I-95] was modified. It is from this modification and restriction that plaintiffs have appealed.

Jurisdiction.

The District Court has jurisdiction of the action under the Declaratory Judgment Statute (Jud. Code § 274-d, 28 U. S. C. A. §400) and by virtue of Judicial Code §24(7), as the actual controversy arises under the patent laws. The appealed judgment is a final judgment of which this Court has appellate jurisdiction (Jud. Code §128, 28 U. S. C. A. 225). Both plaintiffs' and defendant's appeals were timely (26 Stat. 829, 28 U. S. C. A. §230; *Bingham Pump Co., Inc., v. Edwards*, 118 F. (2d) 338 (C. C. A. 9); *Victor Talking Mach. Co. v. George*, 105 F. (2d) 697 (C. C. A. 3); *Claude Neon. Elec. Products v. Brilliant Tube Sign Co.*, 48 F. (2d) 176 (C. C. A. 9)).

Summary judgment [I-96] was entered and filed September 12, 1946. On September 16, 1946, the District Court extended defendant's time to file a motion under Rule 52(b) to amend the findings, conclusions of law and judgment [*id.* 97; *cf. id.* 100-101]. This motion was denied December 18, 1946, except for the addition thereto of paragraph Seventh [I-134] limiting the scope of the injunction of the judgment. It is from this modification of the injunction that plaintiffs appealed [I-134]. The time for appeal commenced to run from December 19, 1946 [I-135], the date the Clerk gave notice of such modification (*Leishman v. Associated Wholesale Elec. Co.*, 318 U. S. 203). Defendant's notice of appeal was filed March 17, 1947 [I-136], plaintiffs' March 18, 1947 [I-138], both within three months thereafter.

Statement of the Case.

Original Letters Patent No. 2,108,538 [II-174-6] were granted February 15, 1938, to defendant containing six claims. This patent was granted on a divisional application. It was surrendered and on August 16, 1938, a reissue (amended) patent, No. Re-20,827 [II-168-171] was granted containing all six claims of the original patent and six new and additional claims numbered 7 to 12, inclusive. Claim 5 was disclaimed [II-171]. Thereafter a further disclaimer attempting to modify claims 8, 9 and 10 was filed [II-172].

While defendant's alleged invention is in the reissue patent No. 20,827 entitled "Means and Method for Turning Rotatable Objects to Predetermined Positions," the claims thereof (7 to 11, inclusive) involved in this suit refer to the tuning mechanism of radio receiving apparatus. The matter here in litigation is the condensers and tuners manufactured and sold as component parts of radio receiving sets by plaintiffs.

Defendant Leishman had notified both plaintiffs in 1938 and 1939 that plaintiffs' tuners and condensers were infringements of Re-20,827 [Complaint par. 5, I-5; admitted Ans. par. 1, I-15]. He had brought two suits for infringement against radio receiving set dealers. The first suit was filed in September 1938 against Associated Wholesale Electric Company in the Southern District of California, which company was selling radio receiving sets manufactured by the Crosley Corporation of Cincinnati, Ohio. In that suit the District Court, after full trial on the merits, entered judgment of dismissal finding claims 7 to 11, inclusive, invalid for want of invention, without deciding the issue of infringement. Upon appeal this Court affirmed the judgment of dismissal. In the opinion (137

F. (2d) 722) reference is made to the defense therein that the patent was for a different invention than that sought to be patented by the original patent. Therein it is said (*id.* 723):

“Thus a reissue patent must be for the same invention as the original patent. Otherwise it is invalid. An original patent and a reissue patent are not for the same invention unless what is covered by the reissue was disclosed in the original and was intended to have been covered and secured by the original. And this intention ‘must appear from the face of the instrument.’ Hence the questions here to be considered are whether what is covered by claims 7-11 of the reissue patent was disclosed in the original patent, and whether it appears from the face of the original that what is covered by claims 7-11 of the reissue was intended to have been covered and secured by the original.”

At pages 723-4 this Court quotes from the original patent the statements of the purposes of the alleged invention including: “to provide means for simultaneously setting the dials of a radio receiving set and a television receiving set;” and states (p. 726):

“Thus the specification of the original patent discloses a combination comprising rockers, tappets and levers, the tappets and levers constituting what the specification calls a lever assembly; and the claims of the original patent are for combinations each of which includes a lever or levers. * * *”

and (p. 727) points out that for this purpose the patent shows and describes a tuner each operating mechanism of which has two rockers 48 and 54, two tappets 61 and 62, and two levers, one pivoted to the other, and refers

(Footnote 13, p. 726) to claims 1-4 and 6 of the original patent. Each of these claims 1-4 and 6 (p. 726) includes in combination with a lever a plurality of rotatable members (*i. e.*, a plurality of rockers) and a plurality of adjustable members (*i. e.*, a plurality of tappets). Some of these claims (for example, claim 2) specifically include two levers (for a lever assembly, one lever being pivoted on the other); and at 727:

“These claims, it will be observed, are for combinations each of which includes a rocker. Whether the combinations include tappets and levers is not clear. If they do not include levers, the claims are not for the same invention as the original patent and hence are invalid. If they do include levers, the claims are not infringed, for the accused device contains no lever.”

This Court, by limiting the claims to a combination including and dependent upon a lever, was able to avoid passing upon this defense of invalidity, and upon such interpretation thereof affirmed the judgment of dismissal. Because “the claims are not infringed,” the Court’s affirmation was without any determination of the other defenses of invalidity, including want of invention, etc.:

“Since the claims, if valid, are not infringed, the question of their validity need not be decided. The judgment declares that the claims ‘are invalid for want of invention.’ In the view we take, the declaration is unnecessary. As to its correctness or incorrectness, we express no opinion.” (*Id.* 727.)

The Supreme Court on December 3, 1943, denied *certiorari* (320 U. S. 794).

On March 7, 1945 [I-39] Leishman filed a second infringement suit against a dealer in radio receiving sets.

This was fifteen months after the denial of *certiorari* by the Supreme Court. This suit was filed in the Western District of Oklahoma against The Richards and Conover Company [I-36]. While this second suit involved condensers and tuners manufactured by plaintiffs and sold to the manufacturers of the radio receiving sets sold by such dealer, neither of the plaintiffs herein were made parties thereof and neither of the plaintiffs controlled the defense in such suit. Such dealer was a customer of Galvin Manufacturing Corporation of Chicago, Illinois [I-53] who purchased condensers and tuners manufactured by plaintiffs and incorporated them into the radio receiving sets sold to The Richards and Conover Company [Complaint, par. 5, I-5-6; Answer par. 1, I-15].

This Court affirmed the judgment of dismissal (137 F. (2d) 722), stating (*inter alia*), "Since the claims, if valid, are not infringed, the question of their validity need not be decided" (*id.* 727). In the opinion of this Court, infringement was not determined as a question of fact. Therein it was a question of law and was so decided. In the case at bar the District Court likewise determined the question of infringement as a question of law. "There is no genuine issue as to any material fact and no controversial question of fact to be determined at a trial respecting the issue of infringement of Claims 7 to 11, inclusive, of Reissue Letters Patent No. Re. 20,827 by plaintiffs' Radio Condenser Company Model 28 tuner or General Instrument Corporation Model 31 tuner" [F. F. 19, I-91], and as a conclusion of law the Court adjudged: "3. No genuine issue as to any material fact exists in the instant case respecting infringement by plaintiffs' manufacture, use, or sale of radio tuners" [I-92].

Plaintiffs' condensers and tuners so incorporated by Galvin Manufacturing Corporation in its radio receiving sets and sold by defendant in said second infringement suit are identified in the record as "Radio Condenser Company Model 28" tuner and "General Instrument Corporation Model 31" tuner [Pltfs. Exs. 2 and 4; F. F. 17, I-91] and are identical (so far as is material to the issue of infringement) with the tuners involved in the *Associated Wholesale Electric Co.* case. This fact is admitted in Appellant's Opening Brief, page 20.

To prevent multiplicity of suits by Leishman against their customers and thereby to prevent further interference with plaintiffs' business, on April 20, 1945, plaintiffs filed the present suit in the District Court wherein Leishman is an inhabitant (Jud. Code §51).

On June 12, 1945, defendant interposed a motion to dismiss this action. The District Court denied this motion and on November 16, 1945, defendant answered the complaint [I-15-17] and counterclaimed alleging infringement by plaintiffs. November 30, 1945, plaintiffs replied to such counterclaim denying infringement and repeating the defenses of invalidity of the reissued patent [I-18-21]. January 23, 1946, plaintiffs moved [I-27] for summary judgment. March 11, 1946 [Rep. Trans.* 1-54] this motion was orally argued and submitted. On the following day, March 12, 1946, this motion was granted and counsel were directed to prepare findings of fact, conclusions of law and a judgment thereon [Rep. Trans. 56-59]. Proposed findings of fact, conclusions of law and proposed judgment were filed March 19, 1946. The

*The reference "Rep. Trans." is to the Reporter's Transcript.

District Court extended to April 1, 1946, defendant's time to file objections thereto.

May 25, 1946 [I-47-51], without any application to and leave or permission of the District Court, defendant filed "Motion to Deny Plaintiffs' Motion for Summary Judgment and Motion to Dismiss the Declaratory Judgment Complaint." The District Court construed the motions as a petition for rehearing [Rep. Trans. 58] of the issue of infringement when, on June 11, 1946 [Rep. Trans. 2-46], they were heard in connection with defendant's objections to the proposed findings and judgment.

At this June 11, 1946 hearing, defendant presented to the District Court a copy of the findings of fact and conclusions of law and interlocutory judgment filed May 6, 1946, in *The Richards and Conover Company* Oklahoma suit [I-52-63]. No amended answer or second counterclaim was presented and no leave was sought therefor.

On June 21, 1946, Leishman presented a motion for leave to file a supplemental answer and a second supplemental counterclaim [I-63-65]. This proposed supplemental answer and counterclaim is not reproduced in the transcript of record herein. It was withdrawn and on July 8, 1946, the proposed first supplemental answer and second supplemental counterclaim, appearing in the transcript of record, pages 72-86, were presented. The District Court, exercising its discretion, denied the motion for leave to file this second-proposed first supplemental answer and second supplemental counterclaim. Appellant asserts error in the denial of such leave.

Appellant propounded certain interrogatories to plaintiffs. The District Court sustained appellees' objections to appellant's interrogatories 4-7, inclusive, 9, 10, 11, 17 and 18. Appellant here asserts this was error.

QUESTIONS INVOLVED.

1. Does either of plaintiffs' tuners comparable to "Radio Condenser Company Model 28" tuner and "General Instrument Corporation Model 31" tuner infringe either of claims 7 to 11 of Re-20,827?

2. Was it an abuse of discretion for the District Court to deny defendant's motion to file "Defendant's First Supplemental Answer and Second Supplemental Counterclaim" [I-72-86]?

3. Did the District Court err in sustaining plaintiffs' objections to defendant's interrogatories 4 to 7, inclusive, 9, 10, 11, 17 and 18 [I-21-26]?

Does Either of Plaintiffs' Tuners Comparable to "Radio Condenser Company Model 28" Tuner and "General Instrument Corporation Model 31" Tuner Infringe Either of Claims 7 to 11 of Re-20,827?

To answer this question it is first necessary to determine, as did this Court in *Leishman v. Associated Wholesale Elec. Co.*, 137 F. (2d) 722, how claims 7 to 11, inclusive, of the reissue patent 20,827 can be interpreted so as to escape invalidity as not for the same invention patented in the original patent 2,108,538.

The applicable principle in law involved is correctly stated by this Court at page 723 of 137 F. (2d):

"Thus a reissue patent must be for the same invention as the original patent. Otherwise it is invalid. An original patent and a reissue patent are not for the same invention unless what is covered by the reissue was disclosed in the original and was intended to have been covered and secured by the original. And this intention 'must appear from the

SUMMARY OF ARGUMENT.

1. Does either of plaintiffs' tuners comparable to "Radio Condenser Company Model 28" tuner and "General Instrument Corporation Model 31" tuner infringe either of claims 7-11 of Re-20,827?

2. First necessary to determine how claims 7-11 of Re-20,827 can be interpreted to escape invalidity as not for the same invention as patented in the original patent.

3. The doctrine of mechanical equivalents applicable to a combination.

4. The legal effect of this Court's adjudication of Re-20,827.

5. A patent for a combination is not infringed by using one element of such combination as an element of a different combination.

6. Coaxiality.

7. The Crosley method of securing coaxiality is not equivalent to that of the reissue patent in suit.

8. Appellant's interpretation of claims 7-11 is wholly contrary to this Court's interpretation thereof.

9. There was no error in the District Court's granting summary judgment in this case.

10. No error exists in the District Court's failure to hold that appellees were bound by the decision in this Oklahoma case, nor in the District Court's denial of leave to appellant to interject this issue into this case.

11. The District Court was correct in sustaining appellee's objections to appellant's interrogatories.

face of the instrument.’ Hence the questions here to be considered are whether what is covered by claims 7-11 of the reissue patent was disclosed in the original patent, and whether it appears from the face of the original that what is covered by claims 7-11 of the reissue was intended to have been covered and secured by the original.”

Appellant’s Opening Brief does not challenge this statement of law.

In the case of *Heald v. Rice*, 104 U. S. 737, 749, it is said:

“In the present case the question of the identity of the invention in the original and re-issued patents is to be determined from their face by mere comparison * * *. That is, if it appears from the face of the instruments that extrinsic evidence is not needed to explain terms of art, or to apply the descriptions to the subject-matter, so that the court is able from mere comparison to say what are the inventions described in each, and to affirm from such mere comparison that they are not the same, but different, then the question of identity is one of pure construction, and not of evidence and, consequently, is matter of law for the court, without any auxiliary matter of fact to be passed upon by a jury, if the action be at law.”

To avoid invalidity because of claiming a different invention, this Court first held that the specification of the original patent gave as one of the novel purposes of the alleged Leishman invention: “to provide means for simultaneously setting the dials of a radio receiving set and a television receiving set; to make it possible for a single manual operation to tune either a radio set or a television

set, or both;” (p. 724), and, second, that to accomplish this purpose the original patent showed and described “a combination comprising rockers, tappets and levers, the tappets and levers constituting what the specification calls a lever assembly; and the claims of the original patent are for combinations each of which includes a lever or levers” (p. 726; *Cf.* Footnote 13); and said (p. 727):

“* * * If they do not include levers, the claims are not for the same invention as the original patent and hence are invalid. If they do include levers, the claims are not infringed, for the accused device contains no lever.”

No facts with respect to the parts composing the claimed combination were in dispute. All were illustrated in the patent drawings and described in the specification thereof. There was no ultimate fact material to the question of infringement to be determined by the Court. As a question of law non-infringement was found.

In *United States v. Esnault-Pelterie*, 303 U. S. 26, 30, it is said:

“* * * where, with all the evidence before the court, it appears that no substantial dispute of fact is presented, and that the case may be determined by a mere comparison of structures and extrinsic evidence is not needed for purposes of explanation, or evaluation of prior art, or to resolve questions of the application of descriptions to subject-matter, the questions of invention and infringement may be determined as questions of law.”

(*Cf. Galland-Henning Mfg. Co. v. Logemann Bros. Co.*, 142 F. (2d) 700, 703, col. 1, to 704 (C. C. A. 7).)

Judge Lederle in *Brown v. Ford Motor Co.*, 57 F. Supp. 825, 827, says:

“Where it appears that extrinsic evidence is not needed to explain the terms of the art or apply the descriptions to the subject matter, and it is possible for the court to determine what are the inventions claimed in the patent, and from a mere comparison of such claimed inventions with the accused devices, determine whether or not infringement exists, the question of infringement, like the construction of any other writing, is a question for determination by the court. *Singer Mfg. Co. v. Cramer*, 192 U. S. 265, 24 S. Ct. 291, 48 L. Ed. 437; *Clark Thread Co. v. Willimantic Linen Co.*, 140 U. S. 481, 11 S. Ct. 846, 35 L. Ed. 521; *Coffield v. Sunny Line Appliance, Inc.*, 6 Cir., 297 F. 609; *Banke v. Novadel-Agene Corp.*, No. 8343, decided by this court Apr. 19, 1939 (not reported), affirmed *Id.*, 6 Cir., 130 F. 2d 99, certiorari denied 317 U. S. 692, 63 S. Ct. 324, 87 L. Ed. 554; *American Fibre-Chamois Co. v. Buckskin Fibre Co.*, 6 Cir., 72 F. 508; *Coulter v. Eagle & Phenix Mills*, 5 Cir., 35 F. 2d 268; *Van Camp Sea Food Co., Inc., v. Westgate Sea Products Co.*, 9 Cir., 28 F. 2d 957; *Hurin v. Electric Vacuum Cleaner Co., Inc.*, 6 Cir., 298 F. 76; *Galland-Henning Mfg. Co. v. Logemann Bros. Co.*, 7 Cir., 142 F. 2d 700; *Bradt v. Kelsey-Hayes, D.C.*, 14 F. Supp. 709; *Gasfier Mfg. Co. v. Ford Motor Co., D.C.*, 1 F. R. D. 10; *Meikle v. Timken-Detroit Axle Co., D.C.*, 44 F. Supp. 460.”

As in *Leishman v. Associated Wholesale Elec. Co.*, the District Court in this case had before it all the ultimate facts upon which to determine infringement. They were presented in and by the original Leishman patent, the re-issue Leishman patent, the disclaimers filed by Leishman, and the tuners themselves, *i. e.*, “Radio Condenser Com-

pany Model 28" tuner and "General Instrument Corporation Model 31" tuner. In the *Associated Wholesale Elec.* case this Court pointed out from this incontestable printed record and the exhibition of the Crosley Radio Corporation's tuner that (137 F. (2d) 727):

"The accused device (a mechanical tuner for a radio receiving set) is manufactured by the Crosley Radio Corporation and sold by appellee. It has a rocker which is the equivalent of appellant's rocker 48. It has no rocker 54 nor any equivalent thereof. It has tappets each of which is the equivalent of appellant's tappet 61. It has no tappet 62 nor any equivalent thereof. It has no lever of any kind or character. Its tappets are operated (made to engage the rocker) by means of plungers. The plungers perform a part, and only a part, of the function performed by appellant's levers F and 66. The part so performed is not performed in the same way, or in substantially the same way. Hence the plungers and the levers are not equivalents."

In the *Paper Bag Co.* case, 210 U. S. 405, the Supreme Court considered and decided the question of infringement therein as "a point of law," *i. e.*, the "range of equivalents" permitted to accord with "the extent and nature of the invention." While this decision is not specifically referred to by this Court in the *Associated Wholesale Elec.* case, eight Court decisions are cited in footnote 18, page 727, supporting in law this Court's determination of the question of equivalency.

As a matter of law this Court found that *in the combination* "the plungers and the levers are not equivalents." In the case at bar the District Court likewise found non-infringement as a matter of law [Cf. F. F. 18, 19, I-91; Conclusions of Law 3, 4, *id.* 92; Judgment, par. 1, *id.*

94-5]. In the *Associated Wholesale Elec.* case this Court did not find,—and in the case at bar the District Court did not find—that a plunger and a lever could not be equivalents of each other in *any* of their possible uses and environments, but that:

“* * * The plungers perform a part, *and only a part*, of the function performed by appellant’s levers F and 66. *The part so performed is not performed in the same way, or in substantially the same way.*” (137 F. 2d 723, 727.)

“Appellant’s levers have a double function—that of operating the tappet 61 and that of operating the tappet 62. *The latter function is not performed at all in the accused device.*” (*Id.*, footnote 17.) (Emphasis supplied.)

This Court thus finds two principles of patent law impelling its judgment of noninfringement:

The first is inherent in and necessary to its limitation of the Re-20,827 to the same invention intended to be patented in and by the original patent 2,108,538, for otherwise the reissue is invalid.

The second is that the elements of the Crosley tuner are not so combined as to perform the discussed function “in the same way, or in substantially the same way” as in the Leishman combination, which is necessarily limited to levers.

Both of these conclusions of law are in full accord with established principles of patent law and in full accord with the clear mechanical facts exhibited in the original patent, the reissue 20,827, and the exhibit tuners.

“* * * The invention, conceding it to be such, is therefore within a narrow compass, and its range of equivalents should be correspondingly limited. (Citing

Boyd v. Janesville Hay Tool Co., 158 U. S. 260; Knapp v. Morss, 150 U. S. 221-228; National Hollow B. B. Co. v. Interchangeable B. B. Co., 106 F. 693-710.) * * * and when the patent is for described means or mechanism to accomplish a specified improvement, it will be limited to the particular means described in the specification, or their clear mechanical equivalents. Union Match Co. v. Diamond Match Co., 162 Fed. 148-155, 89 C. C. A. 172. In patents for a combination, if the patentee specifies any element as entering into the combination, either directly by the language of the claim or by such a reference to the descriptive part of the specification as carries such element into the claim, he makes such element material to the combination and the court cannot declare it to be immaterial. Fay v. Cordesman, 109 U. S. 408-420. * * *” (*Electric Protection Co. v. American Bank P. Co.*, 184 Fed. 916, at 922 (C. C. A. 8).)

**The Doctrine of Mechanical Equivalents
Applicable to a Combination.**

A combination is an entity separate and distinct from its several parts or elements.

“* * * The point to be emphasized is that the law looks not at the elements or factors of an invented combination as a subject for a patent, but only to the combination itself as a unit distinct from its parts, and in such case there can be no comparison of patented and unpatented parts.”

(*Yesbera v. Hardesty Mfg. Co.*, 166 Fed. 120, at 125 (C. C. A. 6).)

Two combinations are not substantially the same or equivalents because each combination secures or produces the same result.

“* * * The patentee may bring the defendant within the letter of his claims, but if the latter has so far changed the principle of the device that the claims of the patent, literally construed, have ceased to represent his actual invention, he is as little subject to be adjudged an infringer as one who has violated the letter of a statute has to be convicted, when he has done nothing in conflict with its spirit and intent. ‘An infringement,’ says Mr. Justice Grier in *Burr v Duryee*, 68 U. S. 1 Wall. 531, 572 (17: 650, 658), ‘involves substantial identity, whether that identity be described by the terms, “same principle,” same “*modus operandi*,” or any other. * * * The argument used to show infringement assumes that every combination of devices in a machine which is used to produce the same effect is necessarily an equivalent for any other combination used for the same purpose. This is a flagrant abuse of the term “equivalent.” ’ ”

(*Westinghouse v. Boyden*, 170 U. S. 537, 568, 42 L. Ed. 1136, 1147.)

“In considering them it is important to bear in mind that the patent is for a combination merely, in which all the elements were known and open to public use. No one of them is claimed to be the invention of the patentee. He does not claim them himself as separate inventions. It is simply a new combination of old and well-known devices, for the accomplishment of a new and useful result, that is claimed to be the invention secured by the patent. * * * But this result or idea is not monopolized by the patent. The thing patented is the particular means devised by the inventor by which that result is attained, leaving it open to any other inventor to accomplish the same result by other means. To constitute identity of invention, and therefore infringement, not only

must the result attained be the same, but in case the means used for its attainment is a combination of known elements, *the elements combined in both cases must be the same, and combined in the same way, so that each element shall perform the same function*, provided, however, that the differences alleged are not merely colorable, according to the rule forbidding the use of known equivalents.” (Emphasis supplied.)

(*Electric R. R. Signal Co. v. Hall Ry. Signal Co.*, 114 U. S. 87.)

Cf. *Union Water-Meter Co. v. Desper*, 101 U. S. 332.

“* * * To sustain the charge of infringement the infringing device must be substantially identical with the one alleged to be infringed in (1) that result attained; (2) the means of attaining the result; and (3) the manner in which its different parts operate and co-operate to produce that result. If the devices are substantially different in either of these respects the charge of infringement is not sustained.” (Citing cases.)

(*Electric Protection Co. v. American Bank P. Co.*, 184 Fed. 916, at 923 (C. C. A. 8).)

“Yet every equivalent, whether asserted in respect of a small or great invention, must respond to the rule enunciated in *Morley v. Lancaster*, 129 U. S. 263, * * *, viz., that where a combination of a plurality of mechanisms constitutes the invention, each mechanism is to be individually considered to determine equivalency, though the result of the plural operations working conjunctively is identical in the patented and accused devices.”

(*Diamond Match Co. v. Sun Match Corp.*, 16 F. (2d) 1, 3 (C. C. A. 2).)

Robinson on Pats., Vol. 1, Sec. 291, p. 403. Cf. *American Steel & Wire Co. v. Denning W. & F. Co.*, 194 F. 117, 118 (C. C. A. 8); *Heyl & Patterson v. M. A. Hanna Coal & Dock Co.*, 279 Fed. 862 (C. C. A. 7); *C. F. Mueller Co. v. Clermont Mach. Co.*, 20 F. (2d) 413; *Stebler v. Porterville Citrus Assn.*, 248 Fed. 927 (C. C. A. 9).

“* * * An equivalent must not vary in any manner the idea of means, or affect it in any degree. It is quite true that the equivalent may perform some new or additional function in the invention, and still be an equivalent; but it must perform all the functions of the element for which it is a substitute in substantially the same way, and I do not think that it is material that the element for which another is substituted has more parts or less parts. The substitution of an equivalent is, however, a mere change of parts and form involving no inventive skill, but suggested by the invention itself to every person skilled in the particular art. If the alleged equivalent not only performs the function of the element for which substituted, and perhaps more, but introduces into the combination a new idea, or new ideas, or a much more extended development of the idea of means, then we do not have the substitution of an equivalent, but a patentable improvement—something different in principle and function. In combination claims this is especially true. (Citing cases.)

“When we have in combination certain elements working together and co-operating to produce a given result, they work in accordance with and in obedience to some law of co-operative action. When we change one element which works and operates differently from the one for which it is a substitute we necessarily change the action of all, and then the combi-

nation operates according to and in obedience to another co-operative law, and we have a new combination working in a different way to produce a result, and it may be the same result; but it is not obtained in the same way by the co-operation of the same elements or their equivalents. Such, in my judgment and opinion, is this case. *It is not enough that the two elements, one of which is alleged to be the equivalent of the other, perform the same function when in the same place; but they must perform that function by applying the same force to the same object, through the same mode of application.*" (Citing cases.) (Emphasis supplied.)

(*Dey Time Register Co. v. Syracuse Time Recorder Co.*, 152 Fed. 440, at 450.)

"In the language used by this court in *Dunkley Co. v. Central California Canneries*, 7 F. (2d) 972, 975, certiorari denied 270 U. S. 646, 46 S. Ct. 347, 70 L. Ed. 778: 'Plaintiff's is a combination patent; all of its elements are old. In such case the patent is limited to the specific combination. A defendant who omits one of the material elements of the combination does not infringe. (Many cases cited.)'

"Again, in *Wilson, etc., Co. v. Union Tool Co.*, *supra*, this court said: 'It is clear that all of the elements of the Double combination patent, No. 734,833, were old in the art. This being true, the claims of invention in the patents should be limited to the specific combinations of elements as covered in the claims of the patent. Combination of elements which are old in the art undoubtedly may be invention, but the combination must be considered as an entirety or unitary structure. If defendant omits one or more of the material elements which make up the combination, he no longer uses the combination; and it is no

answer to say that the omitted elements are not essential, and that the combination operates as well without as with them. *Leeds & Catlin Co. v. Victor Talking Machine Co.*, 213 U. S. 301, 29 S. Ct. 495, 53 L. Ed. 805; *Evans et al. v. Hall Printing Press Co.*, 223 F. 539, 139 C. C. A. 129. It must also be established by one who alleges infringement of a combination that the entire combination, as a unitary structure and having substantially the same mode of operation, is present in the alleged infringing machine. (Case cited.)’ ”

(*Magnavox Co. v. Hart & Reno*, 73 F. (2d) 433, at 444 (C. C. A. 9).)

“There are two tests of equivalency: (a) identity of function; (b) substantial identity of way of performing that function.”

(Deller’s Walker on Pats., Vol. 3, §466, p. 1703.*)

“One thing, to be the equivalent of another, must perform the same function as that other.” (*Id.*, §467, p. 1704.)

“But the test of function is only the first of several tests of equivalency. The fact that one thing performs the same function as another, though necessary, is not sufficient to make it an equivalent thereof.” (*Id.*, p. 1705.)

“Function must be performed in substantially the same way by an alleged equivalent, as by the thing of which it is alleged to be an equivalent, in order to constitute it such.” (*Id.*, §468, p. 1706.)

*The decisions listed in the text as establishing this and the following rules are too numerous for repetition herein.

“* * * In a purely scientific sense, a screw always performs its function in a substantially different way from a lever, and in substantially the same way as a wedge. Screws and wedges are equally inclined planes, while a lever is an entirely different elementary power. But screws and levers can practically be substituted for each other in a larger number of machines than screws and wedges can be similarly substituted. When a lever and a screw can be interchanged and still perform the same function with a result that is beneficially the same, they are said to perform the same function in substantially the same way.” (*Id.*, pp. 1706-7.)

“Similarity or identity of result is not a sufficient test to show infringement, where there was a variation in the means used (*Stebler v. Porterville Citrus Ass’n*, 248 Fed. 927, C. C. A. 9; *Conrader et al. v. Judson Governor Co.*, 238 Fed. 349), * * *.” (*Id.*, §469, p. 1707.)

“But one thing may be an equivalent of another in one environment, and not such an equivalent in another situation. * * * Springs and weights are generally equivalents * * *, but where the environment is such that a spring will operate successfully while a weight will not so operate, there they are not equivalents. * * *.” (*Id.*, §470, p. 1707.)

“An invention of a limited nature is entitled to a narrow range of equivalents. (Citing *inter alia*, *Magnavox Co. v. Hart & Reno*, 73 F. (2d) 433, 435, 441, C. C. A. 9; * * * *Thomas Day Co. v. Doble Laboratories*, 42 F. (2d) 6, 8, C. C. A. 9 * * *; * * * *Overlin v. Dallas Machine & Locomotive Works*, 297 Fed. 7, 11, C. C. A. 9; *Wilson & Willard Mfg. Co. v. Union Tool Co.*, 249 Fed. 729, 734, C. C. A. 9 * * *.” (*Id.*, §475, p. 1719.)

“The following are examples of non-equivalents: *Smith v. Magic City Kennel Club, Inc.*, 282 U. S. 784, 790, 75 L. Ed. 707 (1931), where a patent for improvement in devices for dog races calling for a lure arm, attached or hinged to a conveyor car and equipped with a wheel at its outer end for ground support, held not to cover a rigid horizontal lure-carrying arm without ground support.

“*Columbia Motor Car Co. v. C. A. Duerr & Co.*, 184 Fed. 893, C. C. A. 2 (1911), where a constant volume gas engine was held not the equivalent of a constant pressure engine under a patent entitled to a fair and reasonable, but not a broad, range of equivalents.

“*Stewart-Warner Corporation v. Jiffy Lubricator Co.*, 81 F. (2d) 786, 793, C. C. A. 8 (1936), where it was said:

“‘It seems clear that the compression of spring fingers—elastic members which yield under stress and return to normal when stress is removed—is substantially different from compression by wedging action.’

“*E. Van Noorden Co. v. Cheney Co.*, 75 F. (2d) 298, 302-3, C. C. A. 1 (1934), where it was said:

“‘The construction of a flashing having a single flat rib with parallel sides extending lengthwise of the flashing and wall, with depressions in the rib at regular intervals, each section of the rib thus formed tapering vertically from its center towards the depressions at each end, the entire sheet being crimped into alternate ridges and grooves, with complementary grooves and ridges on the opposite side of the sheet, giving a corrugated effect to each face, the sides of which corrugations do not taper but are parallel, cannot be said, we think, to be an equivalent of the Cheney flashing, with a plurality of ribs and grooves

tapering horizontally in opposite directions and designed to extend across the wall. While the Van Noorden flashing may accomplish practically the same function, it cannot be said to do it in substantially the same manner.' ” (*Id.*, §480, pp. 1725-6.)

Applying these principles of patent law to, and giving claims 7 to 11 of Re-20,827 the interpretation necessary to bring the claimed combination within the confines of the alleged invention “disclosed in the original patent, and * * * intended to have been covered and secured by the original” (137 F. (2d) 723), the findings and conclusions of the District Court [I-91, 92] are fully supported by the indisputable and uncontroverted facts.

The Legal Effect of This Court's Adjudication of Re-20,827.

Appellant misconceives the law applicable to this Court's judgment in the *Associated Wholesale Elec.* case and its legal effect upon the action *sub judice*.

“The patent sued upon was before this court in *Badische Anilin v. Kalle* (C. C.), 94 Fed. 163. It was sustained in all particulars, and infringement found of claims 1, 2, and 4, the same involved here. The *Kalle Case* was appealed to the Court of Appeals in this circuit, and the decision below was affirmed. 104 Fed. 802, 44 C. C. A. 201. According to well-settled practice, the earlier decision in this court is to be followed here, and the decision of the Court of Appeals is, of course, controlling upon this court. * * * The rule is well settled that, when a patent has once been sustained by an appellate court, a subordinate court, dealing with the same patent subsequently, inquires first whether the second record contains anything not before the appellate court (whether mentioned in its opinion or not), and,

if it finds something new, inquires next whether the new matter is of such a character that it may fairly be supposed that the appellate court would have reached a different conclusion, had it been advised of its existence. * * *

(*Badische Anilin & Soda Fabrik v. A. Klipstein & Co.*, 125 Fed. 543, 545-6 (Circuit Judge Lacombe).)

“The defendants first contend that the patent is invalid for want of invention. But, in considering this contention, we are met at the outset with a decree of the Circuit Court for the Northern District of New York holding in a contested case where the same claim was made, and much evidence of the prior art presented, that this identical patent was valid. *Young v. Daley* (decree filed February 25, 1902). Upon appeal the decree was affirmed by this court (120 Fed. 1023, 56 C. C. A. 686), although it appears that the particular errors assigned by the appellant related to other points than the validity of the patent. This decree, being between other parties, does not constitute *res adjudicata*. We are not constrained to follow it upon any principle of *stare decisis*. Still we think an orderly administration of justice in patent causes requires, as a general rule (to which this case does not constitute an exception), that when a patent, after full hearing, has been declared by the Circuit Court to be valid and such decree has been affirmed by this court, we should follow the decision in a subsequent case involving the validity of the same patent, and not presenting any essentially different evidence, notwithstanding the claim of invalidity was not urged upon this court upon the prior appeal.”

(*Crier v. Innes*, 170 Fed. 324, 325 (C. C. A. 2).)

“These same claims were held valid and infringed by the same District Judge in *Concrete Mixing & Conveying Co. v. Ulen Contracting Corp.*, 12 F. (2d) 929. We affirmed that decree without opinion. 12 F. (2d) 931. * * * Subsequently Judge Bourquin held the patent invalid in *Concrete Mixing & Conveying Co. v. R. C. Storrie & Co.* (D. C.), 23 F. (2d) 131. * * *

* * * * *

“* * * But whatever the court as now constituted might think of the correctness of our former ruling, it is our duty to follow it, unless new evidence raises questions of the patent’s validity not previously considered. See *Cortelyou v. Charles E. Johnson & Co.*, 145 F. 933, 934 (C. C. A. 2); *Crier v. Innes*, 170 F. 324 (C. C. A. 2).)”

(*Concrete Mixing, etc., Co. v. Powers-Kennedy Contracting Corp.*, 27 F. (2d) 668, 669, 670 (C. C. A. 2).)

“In the case of *Cortelyou v. Lowe*, 111 Fed. 1005, 49 C. C. A. 671, this court fully accepted and approved the decision in the *Heaton Peninsular Button-Fastener Case* (77 Fed. 288, 25 C. C. A. 267, 35 L. R. A. 728), and by so doing made it, in effect, the law of the Second Circuit. * * * It is a clear, comprehensive and convincing exposition of the law as applicable to the facts as stated in the bill and admitted by the demurrer, and, upon similar facts, is as controlling upon us as if it were originally promulgated by this court. The fact that the court is now differently constituted is, of course, quite immaterial.

If entitled to be considered at all upon a question of general significance, like that under consideration, it should operate as an additional reason for adhering to existing conditions. It is the court, not the individuals composing it, that declares the law; and it would be unseemly, to say the least, to review propositions previously established, even though as an original question we might have been led to a different conclusion. (*Cimiotti Co. v. Nearseal Co.*, 123 Fed. 479, 59 C. C. A. 58.”

(*Cortelyou v. Charles E. Johnson & Co.*, 145 Fed. 933, 934 (C. C. A. 2).)

Compare *Flat Slabs Patents Co. v. Wright, Barrett & Stilwell Co.*, 283 Fed. 345, 346, and cases therein cited; *Jorgensen v. Swope, Warden*, 114 F. (2d) 988 (C. C. A. 9); *Orpheum Bldg. Co. v. Anglim*, 127 F. (2d) 478, 485 (C. C. A. 9).

On behalf of Associated Wholesale Electric Company this Court has adjudged that the Crosley tuners do not infringe claims 7 to 11, incl., of Re-20,827. The District Court was not in error in applying this same measure of the Leishman invention in this case and on behalf of Radio Condenser Company and General Instrument Corporation with respect to tuners patentwise identical with the Crosley tuners. The rule of law is not and should not be different with respect to the rights of different people or corporations. Uniformity of law is necessary to equal justice.

“A Patent for a Combination Is Not Infringed by Using One Element of Such Combination as an Element of a Different Combination.”

(Ajax Forge Co. v. Morden Frog & Crossing Works, 156 Fed. 591.)

Even the use of the identical element of a patented combination is not infringement of that combination where the elements are combined in a distinctive manner forming in substance a different combination.

“* * * The patent is granted for the combination, as ‘the particular means devised by the inventor by which that result is attained,’ and the patentee is entitled to protection against any use of the same combination of elements, combined in the same way, so that each element performs the same function, or against substantially the same use with deviations which are merely colorable. *But each of these well-known elements remains open to the use of the subsequent inventor for a different combination for like results.* Electric Signal Co. v. Hall Signal Co., 114 U. S. 87, 96, 5 Sup. Ct. 1069, 29 L. Ed. 96.” (Emphasis supplied.)

(*Milwaukee Carv. Co. v. Brunswick-Balke-Collender Co.*, 126 Fed. 171, 184-5.)

To this Court’s adjudication that a plunger is not the mechanical equivalent of a lever in the Leishman combination, it is no answer to establish that plungers and levers have been used in other combinations. The District Court found as a fact that no evidence had been presented to the court by defendant to challenge its finding “that plungers and levers in the alleged patented combination do not function in the same way, or in substantially the same way, and are therefore not equivalents” [F. F. 18, I-91].

Even if the pleadings in this case could be construed as presenting an issue of fact with respect to such equivalency, evidence of such fact must be found in the record.

“The existence of an issue of fact on the pleadings does not preclude the court from granting summary judgment if the pleadings, affidavits and depositions show these issues to be feigned or colorable. The court must determine whether there is a genuine issue of fact to be tried. However, the presence of a real and material issue of fact prevents entry of summary judgment, and it is not sufficient that the court may not credit the evidence to be offered or that the weight of the evidence is clearly in favor of one party. The burden is on the moving party to establish the non-existence of a genuine issue of fact and it is not essential that the opposing party file counter-affidavits.”

(*Griffith v. William Penn Broadcasting Co.*, 9 F. R. S. 836.)

Appellant had full opportunity to present any new evidence material to the issue of infringement. Evidence offered by appellant consisted of ten patents [Dfts. Exhs. E to Q, incl., II-177-253] and a “collection of photographs and other illustrations” [I-46] forming a part of his affidavit. Six of these ten patents offered in evidence in this case were before the court in the *Associated Wholesale Elec.* case [Tr. of Rec. Associated Case, Vol. III, Dfts. Exh. J, pp. 567-648; *Cf.* Dfts. Exh. D, p. 566]. The disclosures of the patents to Kettell 290,894 [II-177], Peck 1,865,704 (p. 237), Danish Patent 52,047 (pp. 253,247), Bast 1,687,420 (p. 186), Freytag British Patent 405,716 (p. 201), Gerdes 703,570 (p. 207), Siemens & Halske German Patent 438,696 (pp. 223, 217), Jaoke

2,297,152 (p. 227), Marvin 1,704,754 (p. 189), and Faas 1,928,200 (p. 211) are merely cumulative in illustrating different uses of a plunger. That they are immaterial upon the issue of infringement is clear. None of these patents shows a combination comparable to that of Re-20,827 or the Crosley or Radio Condenser Company Model No. 28 or General Instrument Corporation Model No. 31 tuner, although the fact that a plunger and a lever were both old in mechanics is undisputed. However, the fact is that "the adoption of the pushbutton or plunger means of operation was one of the primary factors of its success, because only through this means of operation was it possible to construct a device that has the required compactness—a definite requirement of the industry." (Quotation from Judge Harrison's decision, 36 F. Supp. 807.)

In this case, to be material evidence of equivalency of a plunger to Leishman's lever in its cooperative relation to the other elements of the Leishman combination, there must be not only a showing and description of a plunger combined in the combination of claims 7 to 11, but the plunger must be so inter-related with the other elements of the combination that each element performs the same function and purpose in the combination, and in substantially the same manner, as does the lever of the Leishman device in its cooperative relation to the other elements of the Leishman combination shown and described in Re-20,827. If these requirements be not met, then there is no equivalency of the plaintiffs' combination to the Leishman combination.

This Court points out that the Crosley tuner:

"* * * has a rocker which is the equivalent of appellant's rocker 48. *It has no rocker 54 nor any equivalent thereof.* It has tappets each of which is

the equivalent of appellant's tappet 61. *It has no tappet 62 nor any equivalent thereof. It has no lever of any kind or character.* Its tappets are operated (made to engage the rocker) by means of plungers. *The plungers perform a part, and only a part, of the function performed by appellant's levers F and 66. The part so performed is not performed in the same way, or in substantially the same way. Hence the plungers and the levers are not equivalents.*" (Emphasis supplied.) (137 F. (2d) 722, 727.)

In order to validate Re-20,827 by restricting it to "the same invention" as "intended to have been covered and secured by the original," this Court points out the absence in the Crosley tuner (as contrasted with the Leishman combination) of three elements, rocker 54, tappet 62 and "lever of any kind" comparable to Leishman's "levers F and 66." It also points out the co-operative relationship of these elements in the Leishman combination. It also points out that the original patent restricted the invention (a combination) to simultaneously tuning in a radio broadcasting station and its associated television broadcasting station.*

At pages 723-4 this Court quotes from the original patent the statements of the purposes of the alleged in-

*Cf. Opinion of this Court, 137 F. (2d), pp. 723-6, wherein, after quoting the specification and claims of the original patent, it is said:

"Thus the specification of the original patent discloses a combination comprising rockers, tappets and levers, the tappets and levers constituting what the specification calls a lever assembly; and the claims of the original patent are for combinations each of which includes a lever or levers. No leverless combination is disclosed or claimed in the original patent, nor does it appear from the face thereof that any leverless combination was intended to have been covered or secured thereby."

vention including: “to provide means for simultaneously setting the dials of a radio receiving set and a television receiving set; to make it possible for a single manual operation to tune either a radio set or a television set, or both;” and states (p. 726):

“Thus the specification of the original patent discloses a combination comprising rockers, tappets and levers, the tappets and levers constituting what the specification calls a lever assembly; and the claims of the original patent are for combinations each of which includes a lever or levers. * * *”

and (p. 727) points out that for this purpose the patent shows and describes a tuner each operating mechanism of which has two rockers 48 and 54, two tappets 61 and 62, and two levers, one pivoted to the other, and refers (Footnote 13, p. 726) to claims 1-4 and 6 of the original patent. Each of these claims 1-4 and 6 (p. 726) includes in combination with a lever a plurality of rotatable members (*i. e.*, a plurality of rockers) and a plurality of adjustable members (*i. e.*, a plurality of tappets). Some of these claims (for example, claim 2) specifically include two levers (for a lever assembly, one lever being pivoted on the other).

We do not read the opinion in this *Associated* case as necessarily limiting the invention to simultaneously operating two shafts, one connected to a radio receiving apparatus, the other to a television apparatus. The opinion refers to the patent's statement of the purposes of the alleged invention as illustrative of the fact that two shafts must be controlled and operated simultaneously,—not that they must necessarily be radio receiving apparatus and television apparatus shafts. We believe that the refer-

ence of this Court in the next to the last paragraph of page 722 of the opinion clearly points this out:

“The specification of the original patent states that the invention therein described ‘relates to improvements in automatic apparatus for turning rotatable objects about their axes to predetermined positions and more particularly to means whereby a plurality of such objects may be immediately and simultaneously rotated to any one of several pre-selected positions or “settings” which may be different for each rotated object.’ ”

and that in order to accomplish this purpose, two rockers 48 and 54, two tappets 61 and 62, and levers F and 66 are required.

This Court points out that the rocker 54, tappet 62 and levers F and 66 are mechanical elements necessarily included as essential to Leishman’s combination’s performance of such simultaneous tuning.

An error of appellant’s argument is thus illuminated, to-wit: that the claimed combination consists of *three* elements and that “Two of the three elements in the Crosley tuner were held by this Honorable Court to be the equivalents of the corresponding elements in the reissue patent here in suit. The third element in the Crosley tuner was held not to be the equivalent of the corresponding element shown in the patent.” (App. Br., p. 12; Cf. 1st par. p. 20.)

The applicable principle of law is that:

“* * * the elements combined in both cases must be the same, and combined in the same way, so that each element shall perform the same function, * * *.” (*Elec. R. R. Signal Co. v. Hall Ry. Signal Co.*, 114 U. S. 87.)

Thus, applying the last quoted rule, this Court points out that, as combinations, the Leishman and the Crosley combinations are separate and distinct; that they are "different combinations" in the patent law sense; and that there is no infringement because there is involved more than a mere substitution of a plunger for a lever. The basis of this holding was not that the use of plungers in lieu of levers was not known and common in the prior art, but that *in the combination* defined by the claims, plungers did not function in the same way as levers. The fact that both plungers and levers had been used in radio tuners in the prior art was shown by the record in the *Associated Wholesale Elec.* case and conceded by both parties to that case.* The patents to Bast 1,687,420, Faas 1,928,200 and Marvin 1,704,754 were cited by the Patent Office in the Crosley application, the file wrapper of which was offered in evidence as Leishman's Exhibit 21. The following is quoted from page 16 of the Reply Brief prepared and filed in this Court on behalf of Mr. Leishman by his attorney, Mr. Flam:**

*In Appellant's Reply Brief in the *Associated Wholesale Elec. Case*, at page 15, there appears in large bold-face type the heading:

"The Invention of Push Button Tuning Goes Back as Far as 1922, and Did Not Bring Automatic Tuning Into Use. The Wide Use of Automatic Tuning Did Not Come Until Appellant's Coaxial Tappet and Treadle Bar Appeared."

**Quoting from page 16, the following appears before this quotation:

"Appellee's statement that the plunger operating means of the accused device is responsible for the wide acceptance of automatic tuning, is at variance with the record.

"These statements are not made in good faith, because appellee's counsel Gibson Yungblut admittedly prepared and prosecuted the Crosley patent application on the accused tuner (II, p. 476) and knows that the claims he wrote on the plunger feature were all rejected because * * *."

Defendant in this *Associated Case* did not contend that Crosley was the first to invent or develop a plunger operated tuner.

“* * * plungers were used in the Bast, Faas and Marvin tuners, patented in 1928, 1933 and 1929, respectively. These patents were cited by the Examiner in the Office Action that appears on pages 20 and 21 of the Crosley file wrapper (appellant's physical exhibit 21). In addition to citing these three patents, the Examiner said:

“‘Claims 15 and 16 are rejected as unpatentable over Marvin. As broadly expressed in these claims, the members 34 of Marvin may be considered to be plungers and the adjustable means thereon the members 35 and 36.

“‘All claims are rejected.’

“However, plungers for automatic tuners go back even further than these patents, the decision in the case of *Jacke v. Long*; *Jacke v. Goldsborough*, 111 Fed. (2d) 184,* stating on page 186:

*In the event that appellant herein misinterprets the reference in Appellee's Reply to Appellant's Supplemental Brief (typewritten) to this opinion as he did in the District Court, it may be desirable to correct the interpretation of the statement that “the facts asserted in such opinion are not before this Court on the record herein.” This assertion definitely is to the facts asserted in such opinion and not “about the mere use of plungers” as claimed by defendant herein in the District Court. This is clear from the text, pp. 34-35, of said typewritten Reply to Appellant's Supplemental Brief.

“* * * Reference in Appellant's Reply Brief herein (p. 16) is to the opinion of the Court of Customs and Patent Appeals in the case of *Jacke v. Long*, 111 F. 2d 184. The facts asserted in such opinion are not before this Court on the record herein. It would appear, however, that the apparatus referred to was of the remote control class, wherein the audio radio receiving set is located at a distance from a series of push buttons which through electrical means cause the tuning shaft of the receiver to be operated. *This class of apparatus* is not exemplified in any of the exhibits in the record herein and is not discussed by any of the witnesses. This seems apparent from the recital (111 F. 2d at 185)—‘The device was, however, in one instance connected with a radio receiver * * * To this end the receiver was disconnected from its normal

“ ‘Subsequently while in California Jacke proceeded to electrify his mechanical unit of 1922. This necessitated the lengthening of the *push button rods*, * * *.’ ”

Cf. Appellant's Supplemental Brief, *Associated* case, pp. 9-15. “* * * *plunger tuners per se were already 15 years old.*” (Emphasis supplied; App. Supp. Br., p. 9.) “Some

location in the bookcase of the living room and transferred to the basement. The electric tuning device was connected to the shaft of one of the two tuning elements of the receiver and the push button pins adjusted for various radio signals. Then by hand tuning the other dial of the radio receiver to a known point for the station desired and pushing a selected button the station was received. * * * Obviously, this construction was not comparable to the Crosley push button plunger tuner, and it is not apparent why this reference is made thereto on p. 9 of Appellant's Supplemental Brief, unless it is to confuse, rather than to clarify, the actual facts upon which this Court is asked to determine the unsupported contention of appellant that The Crosley Corporation secured knowledge of coaxiality from appellant. Likewise, there is no proof that The Crosley Corporation's engineers, in designing and constructing its push button plunger tuners, had knowledge of the Woodbridge or Miller patents or structures.” (Emphasis supplied.)

Appellant urged the District Court herein that:

“Without any evidence before the Court to prove that plungers were well known equivalents in the art when the patent was granted, the appellee prevailed in its false contention that the plunger was an innovation with Crosley, and the Circuit Court accordingly ruled that the plungers of the accused device were not the equivalents of the levers shown in the reissue patent.

“The plaintiffs now retreat to the ground that even if levers and plungers were old in the prior art, they do not function in the same way, or in substantially the same way. The only difference between the functioning of a plunger and the functioning of a lever is that one is a plunger and the other is a lever. Having no evidence that levers and plungers were well known equivalents in this art, the Circuit Court thought that when the tappet is moved by a plunger it is not moved in the same way or in substantially the same way as when it is moved by a lever.” (Defendant's Rebuttal to Reply Memorandum for Plaintiffs, p. 6.)

of the very first mechanical automatic tuners that were suggested, employed plungers (see Rep. Br., pp. 15 and 16, and App. hereof, pp. 1 and 2, for plunger notations on patents cited by appellee), but in those days radio condensers, dial mechanisms, etc., worked so hard that any tuning device that approached commercial practicability had to use a lever instead—in order to get the mechanical advantage that Dr. Mackeown talks about.” (*Id.*, p. 15.) The list of prior patents identified in such appendix as “plunger operated” includes Bast, Marvin, Faas, British Patent to Freytag 405,716, Siemens & Halske German Patent 438,696, and Jacke 2,297,152 [application filed Nov. 20, 1928, II-231].

Merely to prove that a plunger *per se* was a well-known mechanical element does not prove that it was an equivalent of Leishman’s levers F or 66 when incorporated in a combination comparable to the combination of claims 7 to 11. There is nothing in this Court’s opinion in the *Associated Wholesale Elec.* case to indicate this Court considered it material whether “plunger tuners *per se* were already 15 years old.” This Court’s opinion of non-infringement is based upon noncomparability of the Crosley plunger to the Leishman levers F and 66 in the *Leishman combination* to which this Court limited claims 7 to 11; not upon whether a plunger and a lever cannot be equivalent in other relations or combinations. No material issue of fact therein would have been, or in the case *sub judice* was, raised by the offer of the seven patents (App. Br. pp. 34-44). Neither of these patents shows devices wherein a plunger is used in a relation comparable to or having the purpose and function of Leishman’s levers F and 66 in his claimed combination. Hence, on the issue of equivalency in this case, these patents are imma-

terial. This because none of them presents the use of a plunger adapted in its environment to perform in substantially the same way in the associated mechanism the work of the levers F or 66 in the Leishman mechanism. It is not that a plunger is not illustrated but because it is not so positioned and so inter-related that it could be substituted in Leishman's mechanism without a substantial change in the idea of means. Equally applicable is the pointing out by this Court that the Crosley tuner "has no tappet 62 nor any equivalent thereof." "It has no lever of any kind or character. Its tappets are operated (made to engage the rocker) by means of plungers," etc. (137 F. (2d) 727.)

Patent No. 290,894 to Kettell shows two modifications. One figure shows a slidable member having integral projections, the said member being slidable to strike projections upon a rotatable disc, the shaft of the said disc positioning the minute hand of a clock. Figure 2 shows, instead of a plunger, a pivoting member having similar projections, which pivots against a rotatable rod which also moves the minute hand of a clock.

No rocker-tappet-lever combination is shown, nor is a rocker-tappet-plunger combination shown. The members which Leishman calls tappets are but projections of the members which he refers to as plungers and levers. These projections are integral with the so-called plungers and levers and are not, as in the patented combination, pivotally adjustable with respect to the Kettell plunger or lever.

Patent No. 1,865,704 to Peck similarly shows no tappet element. It consists of a rotatable disc on the shaft to be positioned, the disc having links connected to a lever in one modification and to a plunger in another modification. When the lever is depressed or when the plunger is moved,

the links are extended to their furthest positions to move the disc to a predetermined position.

Danish Patent No. 52,047 also does not show tappets pivotally adjustable with respect to either levers or plungers. Figure 1 of the patent shows a plunger having a fixed cam follower roller on its end which coacts with a cam mounted on the shaft to be positioned. Figure 2 shows a similar cam follower mounted on a lever.

Patent No. 1,687,420 to Bast merely shows a rod thrust through a hole in a panel to contact a pivoting member.

Patent No. 1,704,754 to Marvin merely shows plungers slidable through a panel to coact with certain linking members. No tappets, and especially no pivotally adjustable tappets, are here shown.

The British patent to Freytag No. 405,716 shows a plunger which slides to abut against a pivotal member. There is no tappet mounted pivotally and adjustably on the plunger. Moreover, there is no rocker shown in the Freytag patent in the sense of the Leishman patented combination inasmuch as in the Freytag patent the pivotal member is not contacted by the adjustable rod on both sides of its axis, and is thus not confined to a predetermined position.

Patent No. 703,570 to Gerdes, a cash register patent, shows a plunger having a projecting portion which strikes a pivoting member attached to the shaft to be positioned. The plunger does not carry a pivotally adjustable tappet as in the patented combination. Moreover, no true rocker is shown here in the sense of the Leishman patent.

The German Patent No. 438,696 to Siemens and Halske is similar to the plunger modification of Kettell. It shows plungers having integral projections extending therefrom which strike extensions of the shaft to be positioned.

These projections are neither adjustable nor pivotally adjustable as with the tappet in the Leishman patent.

Patent No. 2,297,152 to Jacke does not remotely resemble the patented combination and apparently has been injected into this case merely to show that plungers have heretofore been used in radio tuning apparatus.

Coaxiality.

Interwoven in appellant's arguments of infringement are references to coaxiality. "This substantial coaxial relationship of the rocker and tappet in the tuned-in position is very important. That is the reason it is clearly shown in the drawings and stressed right at the end of the specification in the patent."* (App. Open. Br. p. 18.)

Leishman's original patent 2,108,538 [II-174-6] was addressed to a mechanism for simultaneously, synchronously tuning *two* radio sets, one for radio reproduction, and the other for television reproduction. For accomplishing this, Leishman described and illustrated the provision of two coaxial rockers mounted on a frame, and two coaxial tappets, one for each rocker, mounted on a manually actuated lever. All of the claims in this original patent, except claim 5, specified this dual structure. Claim 5 called for a rocker with two arms, and a means movable about a pivot to effect the angular positioning of the rocker by pushing one of the arms of the rocker—thus rotating it—until the rotation was stopped by the collision

*"When the lever assembly is all the way down, it will be observed from Fig. 2 that the pin 60 is substantially co-axial with the rockers 48 and 54, which means that in this position it is also co-axial with shafts S, 49 and 25, shown in Fig. 1." [II-170, Re-20,827 p. 2, col. 1, ll. 30-34.] The term "coaxial" appears only in claims 8 and 10 [*id.*, p. 3, col. 1, l. 17; col. 2, l. 6].

of the other arm of the rocker with the positioning means. Claim 5 depended for invention upon the substitution of a rocker, as the positioning means, for the more complicated racks and bars of the Schaefer patent 1,906,106 [Trans. Rec. Associated Case, Vol. III, p. 585]. Thus, in this original patent, Leishman claimed he had made an invention in applying Schaefer's lever and tappet to a rocker, as expressed in claim 5, and an invention in a dual tuning means, as expressed in the other claims of the patent. The original patent did not claim any invention in "coaxiality." The sole disclosure of coaxiality is contained in lines 30-36, col. 1, p. 2 of the original patent 2,108,538 [III-516, Associated Case]. What the patent says here is that in Leishman's dual tuning structure the pin 60 on which the two tappets are coaxially mounted should be substantially "coaxial" with the two rockers, which are themselves coaxial on shafts S, 49 and 25, when the lever assembly is all the way down. The purpose of coaxiality here has to do with the operation of tuning. If two tappets, coaxial on the lever, are to operate individually two rockers coaxial on a shaft, it is necessary that the axis of the tappets come down into line with the axis of the rockers when the lever is pressed home. If this is not done, then the contact of one of the tappets with its rocker will block further movement of the lever, and the other tappet, which has not yet fully positioned its rocker, will be prevented from so doing [Mackeown—Trans. Rec. Associated Case II-397-8]. This is a disclosure of the necessity, in a structure having two coaxial rockers and two coaxial tappets, of coaxiality for *operability* when the lever is pressed down. It is not a disclosure of coaxiality in a structure involving but one tappet and but one rocker,

wherein coaxiality is not imperative [*id.*, II-398]. When Leishman came along later to reissue his patent to claim coaxiality in a single rocker, single tappet combination, he reissued his patent for a different invention, and his patent is invalid under the decision of *U. S. Industrial Chemicals, Inc., v. Carbide and Carbon Chemicals Corp.*, 315 U. S. 668. Any contention that Leishman's disclosure of coaxiality in a double tappet, double rocker combination included the other disclosure (*i. e.*, coaxiality involving but one tappet and but one rocker) is answered in said decision:

"This court has uniformly held that the omission from a reissue patent of one of the steps or elements prescribed in the original, thus broadening the claims to cover a new and different combination, renders the reissue void, even though the result attained is the same as that brought about by following the process claimed in the original patent." (315 U. S. 678.)

Appellant's brief is vague as to what is the purpose of coaxiality in a single tappet, single rocker combination. Appellant's Supplemental Brief in the *Associated Case* (p. 24) mentions the "purpose of preventing the freely pivoted tappet and rocker from moving even 'a hair's breadth'." The implication seems to be that this has something to do with operability during tuning, whereas this is not the case. The purpose has to do with ease of adjustment, not during tuning, but during setting. When adjusting a tappet-rocker tuning device to bring in a station, the tappet is released, the lever or plunger pushed home, and the set tuned manually. The manual tuning positions the rocker, which in turn positions the tappet, and then the tappet may be tightened up on the lever or plunger.

The test for coaxiality is whether or not the lever or plunger "walks" when the rocker is rotating the tappet. If it walks, then near the extreme ends of the scale, pressure on the lever or plunger will tend to move the rocker even though the tappet be loose. This is undesirable, because it means that the adjusted position of the rocker may have to be forceably maintained while the tappet is being tightened up. But coaxiality in a single tappet, single rocker combination is not necessary to operability during tuning. As to setting or adjustment, coaxiality is merely a matter of permitting "the parts to move together harmoniously." If members rotating together, like the tappet and rocker during setting, are eccentric or non-coaxial, the pivot points or axes are going to walk. If the parts are coaxial, they will move harmoniously together without walking of the pivots. This is nothing more than the age-old understanding of the competent mechanics of the principles of concentricity and eccentricity.

A radio receiver is customarily provided with a means (usually a variable condenser or gang of variable condensers) which is rotated to tune the radio receiver to a particular broadcasting station to be received. Presumably, a television receiver would have a similar tuning means which upon rotation would tune a television receiver to a television broadcasting station. The reissue patent in suit shows a mechanical device which was intended by the patentee to simultaneously tune both a radio receiver and a television receiver in response to the movement of a single lever.

The reissue patent in suit is not concerned, however, with the electrical characteristics of a radio or of a television apparatus. It is solely concerned with a mechanical device for automatically turning, in response to the

operation of a lever, the tuning controls of a radio and television apparatus to the particular position necessary to tune in the predetermined radio broadcasting station and its associated television broadcasting station.

The devices complained of herein are radio receivers only and have no associated television apparatus. We are concerned in this suit, therefore, only with the portions of the mechanism of the patent in suit which are designed for tuning a radio receiver.

The mechanism of the Leishman reissue patent may be readily understood from a study of the reproduction (Fig. 1 of this brief) of Fig. 2 of the drawings of the reissue patent. Referring to Fig. 1 of this brief, it will be seen that the mechanism of the patent includes a lever A pivoted at Q. The lever A has a projection to which is pivoted a cam or tappet B. A rocker C is mounted upon a shaft which is intended to be connected with the tuning shaft of a radio receiver. The position of the cam or tappet B on the lever A may be fixed by a friction lock actuated by a second lever D pivoted to the lever A and held by a set screw E. The spring F normally holds the lever assembled up and out of the way.

With this apparatus, after the cam or tappet B has been locked in a certain position on the lever A, whenever the lever A is pressed downwardly, as by the operator's finger on the set screw E, the cam or tappet will contact the rocker C and rotate the rocker to a predetermined position. If the cam or tappet has been properly set, this rotation of the rocker C will move the tuning shaft of the radio receiver to the correct position for bringing in a selected radio station.

In the drawing (Fig. 1 of this brief) there appears a second cam or tappet H which is mounted upon the lever

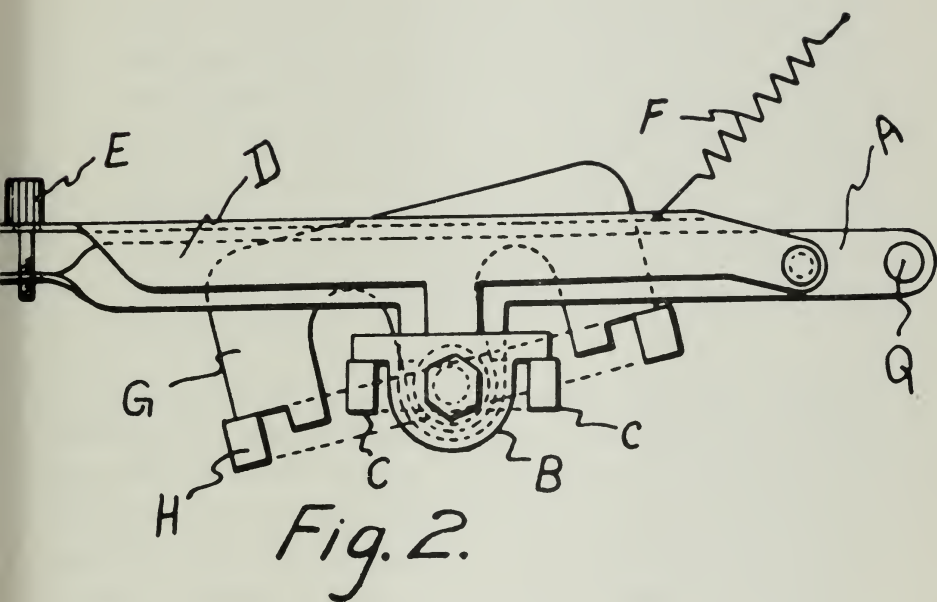


Figure 1
Patent in Suit

A and is shaped to contact another rocker mounted upon a shaft distinct from the shaft of the rocker C, which second shaft is intended to be the tuning shaft of a television receiving apparatus.

Coaxiality was an afterthought with Leishman.

“The fact that the original claim No. 5 made no claim to coaxial relationship and much stress placed thereon in the reissue patent, and that the reissue was not applied for until after plaintiff examined the accused device and became aware of the Marschalk patent, tend to lead one into the belief, that the coaxial relationship was an afterthought, brought into being to save his patent from the defense of anticipation.”

[Trans. Rec. Associated Case, Opinion of District Court, I-28-9.]

Appellant's brief in the *Associated Case* (pp. 16-19) attempted to question this finding of the lower court and to assert that the feature of coaxiality was included in claims 1 and 2 of the original Leishman patent (claims 1 and 2 of the reissued patent). The contention that there is any reference to coaxiality in either claim 1 or claim 2 is fallacious. All that claims 1 or 2 specify is that the adjustable tappets are “pivoted to said lever at a point *substantially* as far from the fulcrum of said lever as said axis is from said fulcrum.” The language relied on by appellant does not define coaxiality. *One* of the *two* things necessary for coaxiality is that the distances be as specified in claims 1 and 2, but this is only one of the two necessary conditions and clearly does not support appellant's contention that Leishman ever had any intention of claiming coaxiality previous to the filing of his reissue patent in suit. [Cf. Trans. Rec. Associated Case, II-412, quoted in Appellant's Brief therein, p. 18.]

By “coaxiality” appellant has reference to the fact that in the device of the patent in suit the axis of the rocker C and the axis of the tappet B coincide at the time the tappet B is in engagement with the rocker C, as illustrated in the drawing, Fig. 1 of this brief. The Court will note in Fig. 1 of this brief that the rocker has two spaced arms C-C and that the downwardly extending rounded portion of the cam B passes between these two arms when the lever A is depressed to bring the tappet B into engagement with the rocker C.

Leishman found *two* conditions necessary to secure coaxiality, the first of these conditions being that the distance between the axis of the rocker C and the pivot point Q of the lever be equal to the distance between the axis of the tappet B and the pivot point Q of the lever. This condition or factor is included in said claims 1 and 2. The second of these conditions is that the tappet and rocker be specially shaped so that the rounded portion of the tappet B be capable of passing between the arms of the rocker for a certain distance. This condition or factor is not disclosed by or made an element of either of said claims 1 or 2—much less is the mechanical structure disclosed or defined, upon which this condition or factor is dependent. (See *General Electric Co. v. Wabash Appliance Corp.*, 304 U. S. 364, 368, 371-2, 374.) The mechanical features or construction which comprise such careful designing must be made a part of the claim, or under *General Electric Co. v. Wabash Appliance Corp.*, they are not a part of the claim. This condition or factor is not disclosed by or made an element of either of said claims 1 or 2—much less are the mechanical structures, upon which this condition or factor is dependent, disclosed or defined. They are not, therefore, a part of the claim

and without them coaxiality is not defined as part of the claim. The applicable principle of patent law is that in interpreting a patent claim anyone, including the courts, “* * * may not add to or detract from the claim * * *” (*Cimiotti Unhairing Co. v. American Fur R. Co.*, 198 U. S. 399, 410).

Reissue claims 8, 10 and 11 are limited to the coaxial relation of the tappet and rocker when the lever is in this Fig. 1 position. Claims 7 and 9 do not directly specify coaxiality. They state only that the rocker C is recessed or hollow. In connection with its contentions directed to the drawing “Appendix A” of appellant’s brief (*Associated Case*), appellant definitely admitted that coaxiality is not established merely because a rocker is recessed or hollow. Appellant does not assert that there is any invention defined by either claim 7 or 9. Merely because a recessed or hollow rocker is specified therein, claiming a recessed or hollow rocker does not necessarily define a coaxial relationship between the tappet and the rocker. Such a coaxial relationship of the tappet and rocker is not specified, and is in fact admitted by appellant not to be specified in either claim 7 or 9. However, unless coaxiality can be read into claims 7 and 9, appellant does not contend that either of said claims defines a patentable invention. It is thus seen that all of the claims in suit are invalid unless the claim includes the mechanical features and relationships which constitute coaxiality, and that coaxiality is the ultimate relation of the parts upon which dependence is placed in support of an argument of invention. Therefore, the statement in the opinion of the District Court in the *Associated Case* is correct,—“* * * the coaxial relationship was an afterthought, brought into being to save his patent from the defense of anticipation” [Trans. Rec. *Associated Case*, I-29; *Cf. F. F.* 18, I-36].

This coaxial relationship was not the invention claimed or patented by the original letters patent. Therefore, this Court did not consider it necessary to refer in its opinion to any portion of appellant's argument based upon coaxiality.

The feature of coaxiality contributes nothing to the accuracy of the device but only facilitates the adjustment of the tappet.

"The coaxial relationship is only important as a means of insuring accuracy at the time of the adjustment of the tappet. It is of importance in that respect for the reason that when the rocker is turned to the proper position for the bringing in of the desired station, the loosened tappet when brought into engagement with the rocker, may be set in proper position by the adjustable means, free from any play. Any play would result in inaccuracies that would destroy the effectiveness of the device. The mechanical problem therefore was to ascertain a means for the accurate and simple adjustment of the tappet. The evidence clearly discloses that the mechanical department of the Crosley Corporation had little trouble in solving this particular problem when it decided upon the use of the rocker and tappet combination. The Marschalk patent used an adjustable means for the adjusting of the tappet, and with this patent as a guide, the problem before a machine designer would be to develop an improvement in the adjusting means: 'Ordinarily there is no invention in making parts of a machine adjustable.' Amdur Patent Law & Practice, P. 148, Par. 57. The adjustable means used by the plaintiff was similar to Schaefer's and the coaxial feature was used solely to prevent play at the time of adjustment.

“Coaxial, simply means on-center and is some times referred to as concentrical or symmetrical. The importance of the mechanical relationship is well known in the art and a feature that must be considered in all machine designing when you desire parts to move together harmoniously and free from friction. The same principle is used in the crank shaft of any automobile. It is a mechanical principle that is hundreds of years old. Both the experts of the plaintiff and the defendant agree in this respect. * * *” [Opinion of the District Court, Associated Case, Trans. Rec. I-29-30; Cf. I-20-22, incl.; I-36-37.]

Since coaxiality between a tappet and rocker is the sole feature which is supposed to endow the claims in suit with the element of invention, it is necessary to ascertain precisely what is actually accomplished in the device of the patent in suit by this coaxial relationship. Appellant's brief makes many confusing statements concerning the necessity that a radio tuner be accurate and contains many references to automatic frequency control circuits. The inference might be drawn from appellant's brief that coaxiality improved the accuracy of the device and eliminated the necessity of employing automatic frequency control circuits. The record in the *Associated Case* establishes without contradiction that coaxiality has nothing to do with the accuracy of the device once the tappet is adjusted, and has nothing to do with the use in the radio art of automatic frequency control circuits, or the failure of the art to use such circuits.

Coaxiality is shown in the record to be a feature which merely facilitates the adjustment of the tappet. It does this and nothing more. The lower court [Associated Case, Trans. Rec. I-27, 28] correctly points out that in

cash registers it is unnecessary to provide a coaxial relationship between the tappet and rocker for the reason that the manufacturer of a cash register knows precisely the amount that the tappet should rotate the rocker, and he governs this by the shape of the tappet. Because of the large number of broadcasting stations on the air today, it is not possible to provide sufficient controls on a radio to enable the user to automatically tune the radio set to all of the broadcasting stations. Accordingly, in a radio receiver it is desirable that the tappets be ajustably mounted on the lever, so that they may be set to bring in the particular broadcasting stations desired by the ultimate user. Coaxiality facilitates the adjustment of the tappet, so that the operation of the lever will bring in the particular station desired by the ultimate user. A typical adjustment of the tappet is as follows (again referring to Fig. 1 of this brief):

The tappet B is first unlocked on the lever assembly so that it is free to turn on its pivot. The lever assembly is then brought down so that the tappet B engages the rocker C. Then, still holding the lever assembly down, the operator tunes the radio receiver by means of the usual hand-tuning knob until the radio receiver is in tune with the particular broadcasting station desired. This operation rotates the rocker, and the rocker in turn rotates the tappet B. When the tappet has thus been rotated to its desired position, the operator locks the tappet in this position by means of the set screw. The adjustment is then complete. Thereafter, when the lever assembly is pressed down, the tappet (which is now locked from rotating with respect to the lever) will rotate the rocker to the position to tune in this particular broadcast-

ing station. This adjusting operation is described in the patent in suit [II-170, p. 2, col. 1, ll. 3-23].

In this adjusting operation, if the axes of the rocker C and the tappet B are concentric or coaxial, the rotation of the tappet B by the rocker will not tend to move the lever A. If the tappet B and rocker 7 are not on concentric axes but on eccentric axes, then the rotation of the tappet by the rocker will require that the lever A move either up or down. The operator may still accurately set or adjust the tappet, but he must be careful during this adjustment and during the subsequent locking of the tappet B by the set screw not to exert too great a pressure on the lever A, or the tappet may slip from the desired position.

It is thus seen that if the rocker and cam are concentric or coaxial during the adjusting operations they are free to rotate together without causing the lever to move up and down. If the axes of the tappet and rocker are eccentric to each other, then lever A *must* move up and down or "walk" when the rocker rotates the tappet during the adjusting process.

It is apparent that coaxiality thus contributes only to the facility with which the tappet may be locked in its intended position, and whether coaxiality exists is thereafter immaterial to the accuracy of the device. Appellant's opening brief in the *Associated Case* (p. 9), stated:

"Once the tappet 61 of the patent in suit or the tappet 44 of Marschalk is accurately adjusted about its respective pivot, repeated operations of the mechanism for bringing the tappet into operative relationship with the rocker will accurately bring the rocker to a preselected position corresponding to the desired station."

The device of the Marschalk patent [Associated Case, Trans. Rec. III-639], which does not provide for coaxiality between the tappet and rocker, is as accurate in tuning the radio apparatus as the device of the patent in suit after the tappet has been locked in position. There is no great difficulty in accurately setting the Marschalk device.

“The Court: * * * The court has tried the instrument and the witness’ testimony does not add anything to what the court has already ascertained from an examination and an effort on its part to work the mechanical device. I had no difficulty in setting the device at the extreme end, but it is true that a person has to use a greater amount of care. That was the result of the court’s own experiment with the instrument.” [Associated Case, Trans. Rec. I-254.]

See also, testimony of Mackeown [*id.*, II-398-9].

In the *Associated Case*, appellant’s brief (pp. 23-24, for example) sought to confuse this Court by drawing a distinction between the use of coaxiality for permitting the tappet and rocker to turn together as a unit and the use of coaxiality so that the tappet and rocker may be in engagement “without either of them moving even a hair’s breadth.” The distinction made by appellant is a mere play on words. At the trial, the testimony of all the witnesses, including Leishman and Loehr for appellant and Mackeown for appellee, was in agreement that the advantage of coaxiality is that during this adjustment process the tappet and rocker are free to turn as a unit, thereby avoiding the necessity of the lever itself moving or “walking” during the adjusting operations. It is, of

course, true that in locking the tappet in its adjusted position it is desirable that any pressure exerted on the lever during the locking procedure shall create no tendency to turn either the rocker or tappet. One, of course, follows the other. The concentric relationship of the tappet and rocker allows them to either turn as a unit as desired in the adjusting process or stand without turning as desired in the tightening step.

Leishman's own definition in the *Associated Case* [Trans. Rec. I-170] of the substance of coaxiality was:

“Q. Why is it that you want these pivots coaxial? What is it you want to accomplish by that?

A. I want to have it so they will move as a unit during the adjusting process and so that there won't be any tendency during the adjusting process for any extraneous movements of the one to move the other.”

**The Crosley Method of Securing
Coaxiality Is Not Equivalent
to That of the Reissue Patent
in Suit.**

Patents on devices and machines are not granted on ideas, principles or abstractions (*Burr v. Duryee*, 68 U. S. 531), but are granted on structures. Even if coaxiality were not old in the art and were not a mere matter of mechanical skill, Leishman still could not obtain a patent of coaxiality as an abstraction or principle. His patent cannot be infringed by another structure merely because such other structure can be characterized by coaxiality, unless the mechanical means for obtaining coaxiality are

substantially the same as the mechanical means of the Leishman patent and function in substantially the same way.* In Appellant's Opening Brief in the *Associated case*, the stress laid by appellant in seeking to distinguish the coaxiality of Leishman from that of Schaefer necessarily leads to the conclusion that Leishman's invention lies only in the particular combination of elements shown containing coaxiality. The Crosley method of securing coaxiality is not the method of Leishman. Leishman secured alignment in the horizontal direction by causing the pivot point of his cam or tappet on the lever and the pivot points of his rocker to lie an equal distance from the pivot point Q of the lever. This mode of securing coaxiality is precisely the same as that of Schaefer. In the Leishman patent, the vertical alignment is obtained by interspaced arms which permit the pivot-carrying portion of the tappet to lie between the arms of the rocker. This again is precisely the same means of obtaining coaxiality as that of Schaefer. But Crosley, in securing horizontal alignment, passed a reciprocating plunger completely through the rocker and provided a side bearing on both sides of the rocker. Coaxiality itself is obtained by entirely different means, with an entirely different mode of operation. The fact that coaxiality is not attained in the accused devices by the method of the reissue patent in

*Pursuant to the argument made on behalf of the defendant in the *Associated Case*, that the Crosley method of securing or effecting coaxiality with the use of plungers differed from the Leishman method of securing coaxiality with the use of levers, this Court in its opinion found that the function performed by the plungers in the defendant's devices "is not performed in the same way, or in substantially the same way" as that performed by the levers in the Leishman combination.

suit appears clearly from the testimony of Dr. Mackeown in the *Associated Case* [Trans. Rec. II-412-14]:

“A. It is the design of the apparatus—the means are quite different but in both cases you get the result that the axis of the cam is located at the axis of the rocker bar. The means of getting them are quite different because one is a lever system and the other is a push rod system.

“Q. That is what I would like you to go into and contrast or compare, so far as that symmetry is concerned, the lever system of the patent in suit and the push button system of the defendant’s accused device.

“A. There are two things that are necessary in the apparatus of the patent in suit to obtain this coaxiality. One is that the distance between the pin 60 and the pivot Q shall be equal to the distance between the pivot Q and the axis of the shafts 25 and S. Then the other is the requirement that the tappets be so shaped that, when the lever is pushed home, the axis of the tappets will line in what I call a vertical direction with the axis of the rocker bars. It should be noted that in the apparatus of the patent in suit the rocker bars have a very considerable thickness. This is practically necessary because they have a small width and to get the adequate strength they must have considerable thickness. And they are pivoted at their centers. This means, then, that the axis of the tappets had to be much lower than the contact points of the tappets. In this respect it differs quite a bit from the device of the defendant where the axis of the tappet is very closely aligned with the contact points of the tappet. That is following the same construction as Schaefer. That has some advantages in having the contact points of the tappet on the same line as the axis. Then, in the defendant’s apparatus, to secure this coaxiality, since you have a push rod

motion, it is necessary to locate the position of the axis of the tappet in both a horizontal and vertical direction so that, when the push button is pushed home, it will line up with the axis of the rocker bar. This is accomplished by having two bearings, slide bearings, for the push rod, one above and one below the rocker bar, and these bearings, in combination with the adjusting washer at the top and the positioning bar at the bottom, locate the center of the tappet so that it will lie in a vertical line which will pass through the axis of the tappet. Then, to locate the horizontal direction, the tappet, or the axis of the tappet, is placed in such a position that you will get coaxiality in the vertical direction. In the design of the defendant's apparatus the axis of the rocker bar is very, very close to the top surface. It is pretty nearly at the top surface. I believe it is about a fiftieth of an inch below the top surface. And for this reason you can put the axis of the tappet and the contact points on nearly the same straight line with advantage. I think that, again, points out the main differences of obtaining coaxiality in the two cases."

To construe the Leishman reissue patent to cover this fundamentally different mode of obtaining coaxiality is to cease to construe the Leishman reissue patent as for a machine, and to construe it as a patent on a principle or abstraction,—

"A function is not patentable . . . The structure and not the function is the thing to be secured by the claim. A functional claim is one that has for its subject the performance of an act merely, and not the means by which that act is executed. It is not for a substantive thing, but for the result which that thing accomplishes . . . A claim for

the function of the invention is void. (Matthews v. Shonberger, 4 Fed. 635; Tyden v. Ohio Table Co., 152 Fed. 183, C. C. A. 6th; Corrington, *et al.* v. Westinghouse A. B. Co., 173 Fed. 69, 78; Heidbrink v. McKesson, 290 Fed. 665, C. C. A. 6th; Mastoras v. Hildreth, 263 Fed. 571, 576, C. C. A. 9th; Hunt, Helm, Ferris v. Coos Libbey Co., 283 Fed. 58, C. C. A. 7th.)” (*Deller’s Walker on Pats.*, Vol. II, §168, pp. 795-6.)

The application of these rules is well illustrated in *Grant v. Koppl*, 99 F. 2d 106, where this Court said (p. 110):

“We note that appellant contends that the claims of the patent in suit read upon appellees’ device. We may assume that this is true, especially as to claim 9. But infringement is not a mere matter of words. *Henderson v. Welch Dry Kiln Co.*, D. C., 26 F. 2d 810, 814; *Goodyear Shoe Mach. Co. v. Spalding*, C. C., 101 F. 990, 994; *Linde Air Products Co. v. Morse Dry Dock & Repair Co.*, 2 Cir., 246 F. 834, 838; *Bird v. Elaborated Roofing Co. of Buffalo*, 2 Cir., 256 F. 366, 373. Here, we hold that the mode of operation is different and that there is no equivalency of means. It is not necessary to discuss the claims separately or in detail. We agree with the finding of the trial court that there is no infringement.”

If the claims of the Leishman patent in suit are not wholly invalid for want of invention, they clearly must be restricted to the thing shown by Leishman. The prior art clearly requires such a construction of the Leishman patent. Every physical element of the structure of

Leishman is old in the art, and in substantially the same combination. Coaxiality—upon which so much stress is laid by appellant—is equally old and was obtained by the prior art in the same way. The structure shown in the Leishman patent is an impractical one and has never had any sort of public or commercial use. Leishman contributed nothing to the practical or theoretical advancement of the art. The patent must be given a narrow construction if the reissue claims are to be sustained.

If the reissue claims can be deemed to express any invention at all, that invention is not found in the accused structure.

Appellant attempted in the District Court to make it appear that the plunger or the lever has nothing to do with coaxiality, but that, on the contrary, coaxiality is tied up with the arrangement between the tappet and the rocker. Infringement is therefore reduced down to a mere substitution of a plunger element for a lever element. This contention was fully presented to this Court in the *Associated Case* and rebutted by the testimony of Dr. Mackeown in that case herein quoted (pp. 55 and 56), where it is demonstrated that the relationship of coaxiality is also tied up in Leishman with the lever, its mounting and its movement, and is tied up in Crosley in a different way with the plunger, its mounting and its movement.

**Appellant's Interpretation of
Claims 7-11 Is Wholly Contrary
to This Court's Interpretation
Thereof.**

Although Appellant's Opening Brief (p. 21) states:

"The decision in the *Associated case* will be better understood if we first apply a couple of the claims at issue to the tuners made by appellees and the Crosley Corporation. The claims, of course, point out the portions of the structure shown in the patent that embody the invention of the patentee,"

its discussion of claim 7 concludes (p. 23):

"* * * It clearly does not include either a lever nor a plunger as an element of the combination. Aside from the spring, it calls only for the rocker and the tappet, the elements shown on page 19 of this brief."

Of claims 9, 10 and 11 it is said (p. 23):

"Claims 9, 10 and 11 are substantially the same as claims 7 and 8 excepting that claims 9, 10 and 11 include a manual operating member. These claims do not specify what kind of a member this must be, because the tappet and the rocker do the real work of the combination, and it makes no difference to these elements whether the tappet is moved by a lever, a plunger, a wheel, a link, a pull-chain, or some other means."

This is clearly erroneous in law. The purpose of this Court's interpretation of these claims was to limit them to the same invention "disclosed in the original patent" and "intended to have been covered and secured by the original" patent. This necessity is specifically recognized by this Court.

No attempt is made in Appellant's Opening Brief to apply the claims as so limited either to Leishman's combination as disclosed in the patent's descriptive specification or illustrated in the patent's drawings, or to compare such an analysis of the claims to the Crosley, Radio Condenser Company Model 28 or General Instrument Corporation Model 31 tuners. Appellant's comparison is worthless as a means or yardstick for determining the question of law involved, *i. e.*, infringement. It is well settled:

"* * * That a claim for a combination to be valid must be for an operative combination is clear. *F. F. Slocomb & Co., Inc. v. Layman Machine Co.* (D. C.), 227 Fed. 94, 104; *Id.*, 230 Fed. 1021, 144 C. C. A. 286; *M'Caslin v. Link Belt Machinery Co.* (C. C.), 139 Fed. 393; *Id.*, 147 Fed. 243, 77 C. C. A. 385." (*Pacific States Electric Co. v. Wright*, 277 Fed. 756, 758 (C. C. A. 9).)

"* * * Otherwise the claim would be invalid as omitting essential elements of the invention." (*Moody v. Thompson Mfg. Co.*, 99 F. 2d 97, 101 (C. C. A. 9).)

The patent in suit cannot be broadly construed to include the plunger type of device complained of herein.

The question of infringement is not alone one of whether the accused device literally responds to the words of the claims of the patent in suit (*Westinghouse v. Boyden*, 170 U. S. 537). Irrespective of the wording of the claims, the scope of every patent is limited to the invention described in the claims contained in it, read in

the light of the specification (*Lehigh Valley Railroad Co. v. Mellon*, 104 U. S. 112; *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U. S. 405; *Motion Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U. S. 502). The question of infringement further involves a determination of the breadth of the claims in the light of the prior art. It cannot be divorced from an inquiry into what, if anything, the patentee has contributed to the art, and whether or not defendant has appropriated *that contribution*:

“In administering the patent law the court first looks into the art to find what the real merit of the alleged discovery or invention is, and whether it has advanced the art substantially. If it has done so, then the court is liberal in its construction of the patent, to secure to the inventor the reward he deserved. If what he has done works only a slight step forward, and that which he says is a discovery is on the border line between mere mechanical change and real invention, then his patent, if sustained, will be given a narrow scope, and infringement will be found only in approximate copies of the new device. It is this differing attitude of the courts toward genuine discoveries and slight improvements that reconciles the sometimes apparently conflicting instances of construing specifications and the findings of equivalents in alleged infringements.” (*Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U. S. 45, 63.)

Leishman shows in his patent a structure having a lever, a cam mounted on the lever, and a rocker upon which his cam acts, with coaxiality between the cam and

the rocker when the lever is pressed home. The claims, no matter what they say, must read upon and be interpreted in the light of this specific apparatus. If some other or different apparatus can be held to infringe the claims, this can be done only by an application of the doctrine of equivalents.

To be an equivalent, an element must perform the same function as the element disclosed, and must perform it in substantially the same way to obtain substantially the same result (*Bates v. Coe*, 98 U. S. 31, 42; *Union Paper Bag Machine Co. v. Murphy*, 97 U. S. 120, 125).

Appellant in order to argue that a patentable invention is present in the substitution by Leishman of a rocker for the rack and pinion of the Schaefer (Zenith) device, has necessarily urged a very narrow application of the doctrine of mechanical equivalents. Having made this argument to distinguish the Leishman purported invention from the Schaefer device, he is bound by the narrowness of this distinction upon which he relies. When the issue of infringement is to be determined, he cannot assert a different and broader application of the doctrine of equivalency, which broad application is necessary to bring the accused plunger-operated device within the scope of the reissue patent in suit.

The patent in suit, we believe, is entitled to no range of equivalents, but must be restricted to the exact thing shown. The cam, the lever, the rocker, and coaxiality are not only all old, but are admitted to be so. If this

leaves the patentee anything at all, it does not go beyond the specific mechanism disclosed.

In *Office Specialty Mfg. Co. v. Fenton Metallic Mfg. Co.*, 174 U. S. 492, 498, the Supreme Court, finding that the Hoffman patent covered the combination “not only of old elements, but of old results, and no new function is evolved from such combination,” restricted the patent to precisely what was shown *in the drawings*.

In the recent case of *Nye & Nissen v. Kasser Egg Process Co.*, 96 F. 2d 420, 423 (C. C. A. 9), this Court found noninfringement on similar grounds, saying:

“* * * It is of course true that the fact that the elements of a combination are old does not negative invention. But where, as here, the prior state of the art shows not only that the elements of a patented combination are not new but that the idea of a patent is embraced in prior patents *designed to do the same work in a similar manner* (such as the patents to Clairemont* in the case at bar) such patent should be narrowly, not broadly, construed.” (Emphasis supplied.)

The device described in the reissue patent in suit has never gone into public use at all. No such device has ever been made or sold. Under these circumstances the patent and its claims must be narrowly construed. This Court in *Henry v. City of Los Angeles*, 255 Fed. 769,

*The Schaefer patent admittedly performs the same function and by the same means, in the present record.

780, quotes the rule from *National Malleable Castings Co. v. Buckeye M. I. & C. Co.*, 171 Fed. 847:

“ ‘The use we make of the fact that the device has never gone into actual service is in the construction or interpretation of the patent. We are justified, in view of the facts of this case, in exercising much caution in attributing to this patent anything more than is plainly shown and distinctly claimed. * * * This inference from nonuse, under the circumstances, is the converse of the inference drawn with respect of a doubtful patent when a showing is made that it has gone into large use and has displaced other devices. It is an inference against utility from the fact of long nonuse, unexplained by want of means or opportunity.’ ”

See, also: *Stewart-Warner Corp. v. Jiffy Lubricator Co.*, 81 F. 2d 786, 793 (C. C. A. 8); *Roberts v. General Elec. Co.*, 85 F. 2d 964, 965 (C. C. A. 3); *Dernell Potato Products Co. v. Snelling*, 38 F. 2d 788, 789 (C. C. A. 2); *Cocks v. Rip Van Winkle Wall Bed Co.*, 28 F. 2d 921 (C. C. A. 9); *Hoppenstand v. Mack-International Truck Co.*, 89 F. 2d 360 (C. C. A. 3); *Shearer v. Atlas Radio Co.*, 94 F. 2d 304 (C. C. A. 6); *Dillon Co. v. Continental Supply Co.*, 98 F. 2d 581 (C. C. A. 10); *Wire Tie Mach. Co. v. Pacific Box Corp.*, 102 F. 2d 543 (C. C. A. 9); *Elvin Mechanical Stoker Co. v. Locomotive Stoker Co.*, 286 F. 309, 311 (C. C. A. 3); *Delaney Patents Corp. v. Johns-Manville Corp.*, 29 F. Supp. 431 (D. C. S. D. Cal.).

The device described and shown in the Leishman patent represents no advance in the art at all over the prior

Schaefer (Zenith) device. It has the same bulky lever construction, and if any effort had been made by Leishman to market his device, it would have been rejected by the trade, for the same reasons that the Schaefer (Zenith) device had to be discarded. Appellant contends that the levers of the Leishman patent are the equivalent of the plungers of the accused Crosley device. The above cases clearly show that we must consider the character of the advance (if any) made by the patentee, in determining whether one mechanical element is the equivalent of the other. In this case it clearly requires the Court to apply the rule that the patent in suit is not entitled to any equivalents, but should, on the other hand, be confined to the specific device shown in the drawings and specification. Clearly, a broad construction of the claims of the reissue patent in suit should not be applied, where such a broad construction would not represent the actual invention of the patent. It is not sufficient to show merely that the lever and plunger accomplish the same result in moving the tappet into contact with a rocker. It must be shown that the means or elements perform their functions in the same way. (*General Elec. Co. v. Parr Elec. Co.*, 21 F. Supp. 471; *Williams Iron Works v. Hughes Tool Co.*, 109 F. 2d 500 (C. C. A. 10); *Union Paper Bag Mach. Co. v. Murphy*, 97 U. S. 120; *National Hollow Brake-Beam Co. v. Interchangeable B. B. Co.*, 106 F. 693 (C. C. A. 8); *Electric Protection Co. v. American, etc. Co.*, 184 F. 916.)

There Was No Error in the District Court's Granting Summary Judgment in This Case.

No issue of fact requiring testimony was presented. Any issue of infringement is a question of law to be decided by the court. As said by the Circuit Court of Appeals, Second Circuit, in *Engl v. Aetna Life Ins. Co.*, 139 F. 2d 469, 472-3:

“* * * The express language of Rule 56, read in its natural context, is to the contrary, for sub. (c) provides that ‘the judgment sought shall be rendered forthwith if the pleadings, depositions, and admissions on file, together with the affidavits, if any, show that, except as to the amount of damages, there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law.’ Here the depositions, taken at their face value, and construed in the light of the underlying law of the state, show that there is no genuine issue of material fact and support the judgment rendered.

“But the matter is sufficiently important so that we should go beyond the bare words of the summary-judgment rule to the reasons behind it. The federal summary judgment proceeding is the most extensive of any jurisdiction in that it is equally available to plaintiffs and defendants and in all forms and kinds of civil actions. But the history of the development of this procedure shows that it is intended to permit ‘a party to pierce the allegations of fact in the pleadings and to obtain relief by summary judgment where facts set forth in detail in affidavits, depositions, and admissions on file show that there are no genuine issues of fact to be tried.’ 3 Moore’s Federal Practice 3175. In New York the question

of constitutionality was settled by considering the procedure as one to determine whether a defense or issue formally stated between the parties was merely sham and not *bona fide*. Formerly this could be determined only on the face of the pleadings; the only essentially new step was to allow such a showing to be made on the basis of detailed affidavits. The rationale is well stated in one of the leading cases establishing constitutionality, *Hanna v. Mitchell*, 202 App. Div. 504, 518, 196 N. Y. S. 43, 55, affirmed 235 N. Y. 534, 139 N. E. 724: 'To say that a false denial, which defendants are unable to justify, must nevertheless put the plaintiff to his common-law proof before a jury, although the result would be a directed verdict in plaintiff's favor as a matter of law, is to exalt the shadow above the substance.' Hence we have often held that mere formal denials or general allegations which do not show the facts in detail and with precision are insufficient to prevent the award of summary judgment. See, for example, *Shotkin v. Mutual Benefit Health & Accident Ass'n*, 2 Cir., 138 F. 2d 531; *Altman v. Curtiss-Wright Corp.*, 2 Cir., 124 F. 2d 177, 180; *Milcor Steel Co. v. George A. Fuller Co.*, 2 Cir., 122 F. 2d 292, affirmed 316 U. S. 143, 62 S. Ct. 969, 86 L. Ed. 1332; *Bushwick-Decatur Motors v. Ford Motor Co.*, 2 Cir., 116 F. 2d 675; *Banco de Espana v. Federal Reserve Bank of New York*, 2 Cir., 114 F. 2d 438, 445; *Piantadosi v. Loew's, Inc.*, 9 Cir., 137 F. 2d 534; *Board of Public Instruction v. Meredith*, 5 Cir., 119 F. 2d 712, certiorari denied 314 U. S. 656, 62 S. Ct. 109, 86 L. Ed. 526."

No Error Exists in the District Court's Failure to Hold That Appellees Were Bound by the Decision in This Oklahoma Case (Spec. of Errors No. 9, I-9), nor in the District Court's Denial of Leave to Appellant to Interject This Issue into This Case (I-134).

Appellant urges this judgment as having two distinct relevancies in this case: (1) as an interlocutory judgment contrary to the court's judgment in the *Associated Case*; (2) that appellees are bound by, and that it is *res adjudicata* between appellant and appellees upon, all issues of this case.

Comity does not compel; it only persuades. The record herein does not contain the answer of defendant in the Oklahoma case. It is not possible from the transcript of the record herein to determine whether the defense that the Re-20,827 is not for the same invention as the original patent was pleaded or properly raised or presented in the Oklahoma case or considered or passed upon by the Oklahoma District Court. There is nothing in the record herein from which this Court can infer that the Oklahoma District Court even had before it this Court's *Associated Case* opinion. No reference thereto is made in the Oklahoma District Court's findings or conclusions [I-52-60]. The interlocutory judgment is likewise silent. It does not even adjudge Re-20,827 to be for the same invention as the original patent. No copy of any opinion of the District Court is available. Appellees' attorneys know of no such opinion.

This interlocutory judgment goes further than this Court's judgment, in that it adjudges Re-20,827 and claims 7-11 thereof valid [I-61, par. 2]. This presents a

question of law that this Court found unnecessary to determine. This interlocutory judgment is contrary to this Court's judgment in that it adjudges appellees' tuners infringed these claims [par. 3; *Cf.* F.F. 26, I-59]. The rationale upon which the Oklahoma District Court decided this question of law cannot be ascertained from examination of anything in this record.

The District Court denied appellant leave to file "Defendant's First Supplemental Answer and Second Supplemental Counterclaim," appearing in the record herein [I-72-86]. Both this proffered pleading and Leishman's affidavit [I-69-72] were filed in the District Court on July 8, 1946. Appellees' motion for summary judgment had been fully argued and submitted to the District Court for decision on March 11, 1946 and granted March 12, 1946 [Rep. Tr. March 11 and March 12, 1946 proceedings]. On June 21, 1946, over three months after this, Leishman filed a "Motion under Rule 15d" to file a supplemental answer and a second supplemental counterclaim* and that the order for a summary judgment be vacated [I-63-64]. This motion was accompanied by an amended pleading which is not reproduced in the printed record herein. This is not the proposed pleading [I-72-86] which was filed on July 8, 1946 and informally treated as a substitute for the June 21, 1946 proposed amended pleading. After a hearing and full discussion in the District Court as to the sufficiency of the June 21, 1946 proposed pleading

*Under Rule 15(a) R. C. P. this was an exercise of the court's discretion. No showing of diligence was made by appellant and none could have been made by appellant. Appellant's brief does not urge any abuse of discretion in this denial. This court cannot review a question of abuse of discretion under such circumstances.

to raise an issue that appellees were bound by the outcome of the Oklahoma suit, for the first time, by this July 8, 1946 proposed pleading did appellant propose to allege that “by participating *and control*” of the Oklahoma suit “the plaintiffs herein are bound by the outcome of that suit; * * *” [I-79, par. XIII].

The District Court knew from the arguments of counsel that mere participation was insufficient and that control by appellees was necessary to effect estoppel by judgment and that the proposed amended pleading, filed July 8, 1946, was proffered in order to allege control of the defense of the *Oklahoma Case* by appellees. The District Court knew this allegation was sham.

In *Hy-Lo Unit & Metal Products Co. v. Remote Control Mfg. Co.*, 83 F. (2d) 345, this Court points out that one is not bound by the judgment in a case wherein he was not a party, “even though it be assumed, as alleged, that it participated in the defense of that action and defrayed part of the expense of defending it” (p. 349); that control of the defense is necessary to create the estoppel by judgment, quoting (*inter alia*) from *Bigelow v. Old Dominion Copper Mining & Smelting Co.*, 225 U. S. 111:

“* * * ‘To conclude Bigelow by the New York judgment, it must appear that he was either a party or a privy. That he was not a party to the record is conceded. He had no legal right to defend or control the proceedings, nor to appeal from the decree. * * * That he was indirectly interested in the result because the question there litigated was one which might affect his own liability as a judicial precedent in a subsequent suit against him upon the same cause of action is true, but the effect of a

judgment against Lewisohn as a precedent is not that of *res judicata*. * * * Nor would assistance in the defense of the suit, because of interest in the decision as a judicial precedent which might influence the decision in his own case, create an estoppel as to Bigelow.' * * *

Cf. also, this court's comments (p. 350) upon its decision in *Carson Investment Co. v. Anaconda Copper Mining Co.*, 26 F. (2d) 651.

Herein the District Court considered not merely the proposed amended answer's allegation of participation and control but also the affidavit of appellees' counsel Maxwell James [I-66, 68] wherein it is stated:

"(2) At no time has either of the plaintiffs, Radio Condenser Company or General Instrument Corporation, controlled the defense or participated in any pecuniary or other manner in the control of the defense in the case of LeRoy J. Leishman vs. The Richards and Conover Company, pending in the United States District Court for the Western District of Oklahoma."

* * * * *

"(4) * * * Deponent (for himself and on or in behalf of either of the plaintiffs herein) had absolutely no voice even as to the manner in which these models were to be used at the Oklahoma trial, and deponent (again for himself and on or in behalf of either of the plaintiffs herein) had no voice whatsoever in directing, determining or in any wise controlling any phase whatsoever of the trial in the Oklahoma case."

The alleged "participation" is shown to have consisted merely in lending to Mr. Mueller (attorney for defendant

in the *Oklahoma Case*) two models, both of which had been in Mr. James' possession for years [I-67]. Contrary to the statement of Appellant's Opening Brief (p. 57), "for which the model was constructed," neither of these models was constructed for the *Oklahoma Case*.

Appellant's evidence, accepted at full face value, demonstrates that the allegation that appellees possessed or exercised *control* of the defense of the *Oklahoma Case* is sham. The record herein thus "* * * show(s) that there is no genuine issue of fact to be tried" (*Engl v. Aetna Life Ins. Co.*, 139 F. (2d) 469, 472, *supra*), and that summary judgment is not to be denied by feigned issues.

The District Court Was Correct in Sustaining Appellees' Objections to Appellant's Interrogatories (Spec. of Errors No. 7, App. Opening Br. p. 9).

This ruling had no pertinency to the appealed Summary Judgment. These interrogatories appear at I-21-24; appellees' objections thereto at I-25. They inquire how many automatic tuners or actuators appellees have sold since the specified dates; that appellees furnish accurate drawings and samples of each type made by appellees since February 15, 1938; how many appellees sold to Wells-Gardner & Co. and to Delco Radio Division of General Motors Corp. This information could be material only on the issue of damages under appellant's counterclaim, paragraph II [I-16], and could not affect the summary judgment that there was no infringement.

BRIEF ON PLAINTIFFS-APPELLEES' CROSS-APPEAL.

Only one question is raised by this cross-appeal, *i. e.*, the restriction of the injunction of the Summary Judgment as originally entered [I-95-6, pars. 3 and 4] by the addition of a seventh paragraph reading:

“This judgment shall not be construed to mean that the defendant is enjoined from proceeding in the case of LeRoy J. Leishman v. The Richards and Conover Company, Civil Action No. 2155 of the United States District Court for the Western District of Oklahoma, and defendant is not enjoined from proceeding against Galvin Manufacturing Company.”

It is a fact that the tuners involved in the *Oklahoma Case* were manufactured by appellees and sold to their customers for and installed in the radio receiving sets completed by Galvin Manufacturing Company [Complaint, par. 5, I-5-6, admitted Answer, par. I, *id.*, 15; *Cf.* further Oklahoma Case F.F. 26, I-59; Conc. Law 2, I-60].

The injunction constituted “Further Relief” as provided for in paragraph (2) of the Federal Declaratory Judgment Act (§400, 28 U. S. C. A. p. 236) and intended to protect the rights adjudged in appellees by the declaratory judgment. The continued molestation of appellees’ customers and users of appellees’ tuners by filing or prosecuting suits and threats of suit, based upon the wrongful assertion that appellees’ tuners infringe, is a violation of appellees’ rights under the judgment herein.

The principle of *Kessler v. Eldred*, 206 U. S. 285, is directly applicable. Kessler filed suit for an injunction against Eldred "to enjoin Eldred from prosecuting any suit in any court of the United States against anyone for alleged infringement of the Chambers patent by purchase, use, or sale of any electric cigar lighter manufactured by Kessler and identical with the lighter in evidence before the circuit court for the district of Indiana and the circuit court of appeals for the seventh circuit in the (previous) trial and adjudication (of noninfringement) of the suit of Eldred against Kessler." (206 U. S., at 286.) The case came before the Supreme Court upon certification of four questions:

"First. Did the decree in Kessler's favor, rendered by the circuit court for the district of Indiana in the suit of Eldred against Kessler, have the effect of entitling Kessler to continue the business of manufacturing and selling throughout the United States the same lighter he had theretofore been manufacturing and selling, without molestation by Eldred, through the Chambers patent?

"Second. Did the decree mentioned in the first question have the effect of making a suit by Eldred against any customer of Kessler's for alleged infringement of the Chambers patent by use or sale of Kessler's lighters a wrongful interference by Eldred with Kessler's business? (206 U. S. at 286.)

* * * * *

"* * * it is Kessler's right that those customers should, in respect of the articles before the court in

the previous judgment, be let alone by Eldred, and it is Eldred's duty to let them alone. The judgment in the previous case fails of the full effect which the law attaches to it if this is not so. If rights between litigants are once established by the final judgment of a court of competent jurisdiction those rights must be recognized in every way, and wherever the judgment is entitled to respect, by those who are bound by it. Having, then, by virtue of the judgment, the right to sell his wares freely, without hindrance from Eldred, must Kessler stand by and see that right violated, and then bring an action at law for the resulting damage, or may he prevent the infliction of the unlawful injury by proceeding *in personam* in equity? If Eldred succeeds in his suit against one of Kessler's customers, he will naturally bring suits against others. He may bring suits against others, whether he succeeds in one suit or not. There may be, and there is likely to be, a multiplicity of suits. It is certain that such suits, if unsuccessful, would, at the same time, tend to diminish Kessler's sales, and to impose upon him the expense of defending many suits in order to maintain the right which, by a judgment, has already been declared to exist. If the suits are successful the result will be practically to destroy Kessler's judgment right. Moreover though the impairment or destruction of Kessler's right would certainly follow from the course of conduct which Eldred has begun, it would be difficult to prove, in an action at law, the extent of the damage inflicted. An action at law would be entirely inadequate to protect fully Kessler's unques-

tioned right, and, under these circumstances, though there may be no exact precedent, we think that the jurisdiction in equity exists. Nor do we see any good reason why Kessler's interposition for the defense in the suit of Eldred v. Breitwieser debars him from his remedy in equity.

"It follows from the foregoing reasoning that the first and second questions certified should be answered in the affirmative, and the third and fourth in the negative, and it is so ordered." (*Id.*, 289-290.)

Cf. Toledo Scale Co. v. Computing Scale Co., 261 U. S. 399, 426; *Steelman v. All Continent Corp.*, 301 U. S. 278, 291; *Commercial Acetylene Co. v. Avery Portable Lighting Co.*, 159 Fed. 935 (C. C. A. 7); *Goodyear T. & R. Co. v. Rubber Tire W. Co.*, 164 Fed. 869, 871; *Bryant Elec. Co. v. Marshall*, 169 Fed. 426, 430.

The appealed judgment is a final adjudication of the duty of appellant and is entitled to respect by appellant, who is bound by it. The injunction is not addressed to the Oklahoma District Court or the Circuit Court of Appeals of the Tenth Circuit, if the *Oklahoma* case is carried to that court. Like the suit of *Eldred v. Breitwieser*, appellant's prosecution of this *Oklahoma* suit is "a wrongful interference by Eldred (Leishman) with Kessler's (plaintiffs') business." Appellant's avowed purpose in that suit is to secure a decision which is in conflict with the judgment in this case. From a legal standpoint, appellant's error was in bringing such a suit against customers of plaintiffs. The injunction herein would not bar appellant from bringing suit for infringement against anyone other than plaintiffs' customers.

Conclusion.

Appellees submit:

- (1) That the summary judgment should be affirmed;
- (2) That the restriction of the injunction should be eliminated; and
- (3) That appellant should be enjoined so as to compel him to fully observe the obligation and duty imposed upon him by the law.

Appellant's position is that this Court's judgment in the *Associated case* was wrong and that the judgment of the District Court herein was wrong. Appellant does not, however, point out how Re-20,827 can be interpreted so that it patents the same invention as the original patent, except upon this Court's interpretation. Any other interpretation would leave Re-20,827 invalid as not for the same invention as the original patent.

Under this Court's interpretation of Re-20,827 the additional patents raise no material issue of fact.

Respectfully submitted,

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